

Institut der beim Europäischen  
Patentamt zugelassenen Vertreter

Institute of Professional Representatives  
before the European Patent Office

Institut des mandataires agréés près  
l'Office européen des brevets

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Verlag / Publishing House / Maison d'édition

Carl Heymanns Verlag  
Eine Marke von Wolters Kluwer Deutschland GmbH  
Luxemburger Straße 449  
D-50939 Köln  
Tel. (0221) 94 373-7000  
Fax (0221) 94 373-7201  
Kundenservice: Tel. (02631) 801-2222  
[info@wolterskluwer.de](mailto:info@wolterskluwer.de)  
[www.heymanns.com](http://www.heymanns.com)

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Anzeigen / Advertisements / Publicité

Carl Heymanns Verlag  
Eine Marke von Wolters Kluwer Deutschland GmbH

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Druck / Printing / Imprimeur

Grafik + Druck GmbH, München  
ISSN 1434-8853  
© Copyright epi 2010

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#### **Vierteljahreszeitschrift**

Abonnement im Mitgliedsbeitrag enthalten, für Nichtmitglieder € 48,00 p.a. zzgl. Versandkosten (€ 9,90 Inland / € 14,00 Ausland), Einzelheft € 19,00 zzgl. Versandkosten (ca. € 2,27 Inland/ ca. € 3,20 Ausland) je nach Heftumfang. Preise inkl. MwSt. Aufkündigung des Bezuges 6 Wochen vor Jahresende.

#### **Quarterly Publication**

Subscription fee included in membership fee, for non-members € 48,00 p.a. plus postage (national € 9,90 / abroad € 14,00), individual copy € 19,00 p.a. plus postage (national about € 2,27, abroad about € 3,20) depending on the size of the issue, VAT included. Cancellation of subscription is requested 6 weeks before any year's end.

#### **Publication trimestrielle**

Prix de l'abonnement inclus dans la cotisation, pour non-membres € 48,00 p.a., frais d'envoi en sus (national € 9,90 / étranger € 14,00), prix à l'unité € 19,00, frais d'envoi en sus (national environ € 2,27, étranger environ € 3,20) selon le volume du numéro, TVA incluse. Résiliation de l'abonnement 6 semaines avant la fin de l'année.

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## Editorial

T. Johnson (GB)

„They're changing the guard at Buckingham Palace....says Alice". So goes an English poem which effectively became a well-loved nursery rhyme. It may not be a palace, but the EPO has a new incumbent as President, Benoît Battistelli. We wish him well, particularly as the quoted poem above goes on to say, „...a soldier's life is terribly hard“.

Having interviewed the new President during the process which lead up to his election, we are sure he will embrace the „hardness“ and do his utmost for the Office and its users, including of course, our profession. For further information, please see the interview with him in this issue, which sets out his initial thoughts and philosophy on taking up his new role. We are grateful to him for giving us a second tranche of his valuable time.

The new President picks up the EPO gauntlet at an interesting time in IP, both globally and from a European perspective. Despite the economic troubles the world is experiencing, the major Offices are generally seeing a rise in pending applications, adding to the infamous

backlog. But nowadays there does seem to be a consensus that co-operation, not competition between Offices is the way forward. Various schemes are in hand to try to enhance the system, eg. The Patent Prosecution Highway, work-sharing between offices, and the European Patent Network to name but a few. WIPO is also a player here, providing via the PCT ways to enhance „sharing“, eg. of ISAs. Please see a report in this issue of the joint FICPI/AIPLA conference in Edinburgh which addressed these issues.

The profession can help in the endeavour to improve the system. Thus we in the profession should look at our own practises to see how we can work with the Office in endeavouring to obtain a quality patent without undue or unnecessary delay for our clients.

So the „guards“ are closing ranks to provide a solid front for facing these challenges. With good will on all sides, these challenges can be met, hopefully successfully.

### Nächster Redaktionsschluss für epi Information

Informieren Sie bitte den Redaktionssausschuss so früh wie möglich über das Thema, das Sie veröffentlichen möchten. Redaktionsschluss für die nächste Ausgabe der epi Information ist der **3. November 2010**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

### Next deadline for epi Information

Please inform the Editorial Committee as soon as possible about the subject you want to publish. Deadline for the next issue of epi Information is **3<sup>rd</sup> November 2010**. Documents for publication should have reached the Secretariat by this date.

### Prochaine date limite pour epi Information

Veuillez informer la Commission de rédaction le plus tôt possible du sujet que vous souhaitez publier. La date limite de remise des documents pour le prochain numéro de epi Information est le **3 novembre 2010**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

## The new President in Conversation with *epi*

Benoît Battistelli, President of the European Patent Office since July 1, 2010 has granted an interview to the *epi* via the Editorial Committee<sup>1</sup>.

Mr. Battistelli who is a law graduate and former student at the Paris Institute of Political Science (IEP) and the National School of Administration (ENA) held several important positions in the French Ministry of Economic, Financial and Industrial Affairs. In 1999 he became Deputy Undersecretary with responsibility for innovation, competitiveness and industrial property policy. Mr. Battistelli also served as chief advisor to Nicole Fontaine, a former President of the European Parliament, when she acted as French Industry Minister.



From his temporary offices President Battistelli overlooks Munich. The Frauenkirche is visible in the far distance, the Oktoberfest „meadow“ lies below. A fitting location for a person who by necessity has to be farsighted and circumspect to preside over an international organisation with a staff of more than 6000, mostly academics and graduates, in four different European locations, the first and largest organisation of its kind in Europe. „For the first three months I have decided to visit the different sites of the Office and to get acquainted with as many of our staff as possible; indeed, since taking office I have already addressed more than 2500 persons,“ says the new President. „It is important that I obtain an understanding of the reality of the European Patent Office which is a unique multicultural success story. One of my main aims is to build up or rebuild confidence and trust between all players in the Office; the staff, its representatives and the management. I am optimistic as concerns the future of the Office, we are again facing rising filing numbers“.

The new President enjoys an initial advantage. He knows the Office from inside, having been a member of the Administrative Council of the organisation as Director General of the French Patent Office INPI since 2004. From 2005 to 2008 he has also been the Chairman of the Supervisory Board of the European Patent Academy and has furthermore been elected Chairman of the Administrative Council of the organisation in 2009, before taking over as President.

Our interview, it turns out, does not strictly follow the relevant *epi* questions we had prepared in advance, although it touches upon nearly all of the envisaged issues. The President deals with our questions in an

analytical and pragmatic manner. He dissects problems, such as the one concerning the overall situation of the Office. The President would like to „determine the margin of manoeuvre the Office has over the next years,“ – his term of office is five years. „I have therefore initiated an analysis to be performed by external professionals. Two tenders for contractors have been circulated, one regarding the budgetary and financing situation of the Office, the other concerning IT. The results should be available in three months time. Therefore, choices will have to be made at the beginning of 2011. The European Patent Office after all is a public organisation working for the Member States and for the general interest of the European public at large, rather than a company that has to make profit“.

When asked about cooperation with the profession, the President confirmed that he favours a regular institutionalised consultation process with perhaps two regular meetings a year, with further meetings, if certain developments render them necessary. Such meetings, between the EPO President and his directors on the one side, and the *epi* presidency on the other side have indeed become an institution in the past. Our President, Kim Finnilä, therefore welcomed President Battistelli's offer. President Battistelli also acknowledged that the decision making process within the Office – „I have noted you were unhappy with some decisions in the past“ – should include regular meetings with the profession and interested circles before decisions are taken. Again, with his analytical approach, the President would like to see discussions on general topics separated from those on technical topics, with those arising from special matters being kept separate from the other two.

Another of our questions related to the cooperation programme of the Office with national patent offices (NPOs) in the framework of the European Patent Network (EPN). There the President invoked the multinational structure of Europe and the fact that cooperation should be enhanced, including an increase of the present budget for the cooperation programmes, which the President considers too low. „One could for such an important programme spend much more“, says the President. „We will create tools for everybody so that with our material everybody could enjoy the same standard. At the end of the day, the EPO has the final competence, and will have to take the responsibility for any cooperation result. The examiners must be free to use material from NPOs or not“. As to the tasks of the NPOs, the President noted that times have changed. NPOs are no longer regarded as competitors of the EPO, rather on the contrary NPOs are a complement, as they mirror European diversity. „One has to take into account European reality and Europe's multinational structure, therefore we require a network of offices, however the EPO must be at the head of the network with a central responsibility. When the EPO develops the assets and

<sup>1</sup> *epi* President Kim Finnilä and Walter Holzer for the Editorial Committee participated in the interview

IP/IT tools for technical cooperation with NPOs, it invests in training, which is more favourable than the distribution of certain quotas of work entrusted to NPOs by the Office", is the President's view.

Another topic of interest for the profession, the concept of „Raising the Bar“ in European examination finds a supporter in President Battistelli. After all, he also considers the idea of a high quality European patent in the long run a must. „Patents should in reality mirror the technical progress purported by the invention in question“. In this respect, we mentioned the reluctance of the profession as regards observing any „rules of best practice“, as obviously each patent case requires its own rules. The *epi* asked whether there is a chance that the Guidelines for Examination would in the future also comprise the examiner's *internal guidelines*. We learned that there is indeed a project to combine the two, although this is a huge task as about 1000 pages would have to be combined. „If on the other hand, internal rules or orders have to be passed on to the examiners, those will stay internal“, was the final remark of the President.

We also asked President Battistelli how he views the activity of the Administrative Council of the organisation in the forthcoming years, after times when there were blocks or factions of countries pursuing different interests. „In my view the Council is less divided than before, when we had a strategic debate. The cooperation within the Council and between the Council and the management of the Office runs smoother than before, even with a large Council of 37, soon 38 Member States“, says the President. „My election is a proof of this fact, because I was elected with a three quarters majority“. As to the question of centralisation he says, „I do of course favour centralisation, although one must recognize that there are diverse European cultures, and it is quite natural that neighbouring countries or countries with a common cultural heritage share the same interests. The Member States however should reflect on their national role and their contribution to the common cause“.

As concerns the probably forthcoming European Union Patent, the *epi* asked: „In the interview we made with you when you ran for the presidency you emphasized the need for a Community patent, as it was called at that time. You also noted that therefore the president of the EPO should come from an EU Member State. What is your view on this question now, after your second wish has come true?“

„I am still in favour of the EU Patent, in particular with the envisaged three language solution. We should not become a second OHIM. After all, the regime of the European Patent prevails. The Community Patent will be a European Patent anyway, simply one for the European Union.“ Would then the accession of the European Union to the European Patent Convention create a

problem? The President says: „Yes, of course, because of the necessary revision of the EPC. The ratification procedure would take ten years. However, there is an alternative solution on the basis of a bilateral agreement. It is not necessary that the European Union joins the European Patent Organisation, it could simply subcontract the granting of Community patents to the European Patent Organization“. The President acknowledges that problems with regard to the avenues of appeal might come up, however, these matters would then have to be carefully analysed and resolved.

As for the remaining language issue, the President supports the idea of machine translation for information purposes. „Of course,“ he says, „these translations cannot be of a legally binding nature, such documents would still have to be produced by experts. However for information purposes, machine translations would be sufficient, after all, the quality of machine translation increases“. Your reporter noted that the perhaps we as patent attorneys would have to change our style of working, by drafting specifications with shorter sentences and by using precise terms, in order to enable the machine to do a translation of higher quality! Man supports machine, an intriguing idea, perhaps justified. One can invoke the famous French film maker Jean-Luc Godard, who when asked about his working credo answered: „Faire une description précise“.

Turning to the question of training in general, namely that of European patent attorneys and examiners likewise, as well as to the role of the European Patent Academy, the President remarked that he sees a difference between the work of patent attorneys and examiners: „European patent attorneys have to draft and defend patent specifications, whereas the examiner's task is to criticise them. Thus there is a different approach to performing the two tasks, and therefore also the training needs to be different“. President Battistelli furthermore said that he was clearly in favour of the activities of the European Patent Academy, in particular its activities for the Member States. „As you know, I always supported the idea of an Academy and as you also know I was the first Chairman of the Supervisory Council of the Academy. I believe that the main task of the Academy is training and support for NPOs, judges, patent attorneys and experts.“

At the end of our interview, the President's stated his modest outlook: „After my mandate of five years, the EPO should be recognized as the best patent Office in the world, with a sound budget, costs under control and backlogs reduced“. The *epi* cannot but concur and wishes President Battistelli all the best for his endeavours, and looks forward to continuing cooperation with the President and his Office.

Walter Holzer  
Editorial Committee



# Wahl zum Rat des Instituts

Anfang des nächsten Jahres ist der Rat des Instituts neu zu wählen.

Wir möchten auf die Versanddaten der Dokumente, die auszufüllen sind, sowie die Fristen für den Eingang der ausgefüllten Dokumente im Sekretariat des Instituts in München hinweisen.

## 1. Schritt

– *spätestens am 1. Oktober 2010:*

Versand des Wahlvorschlag-Formulars zum Nominieren von Kandidaten an die Institutsmitglieder.

– *1. November 2010:*

Fristablauf für den Eingang des ausgefüllten Wahlvorschlages im Sekretariat des Instituts.

## 2. Schritt

– *spätestens am 1. Dezember 2010:*

Versand der vorläufigen Kandidatenlisten an die Personen, die zur Wahl vorgeschlagen wurden.

– *10. Dezember 2010:*

Fristablauf für den Eingang schriftlicher Anträge zur Änderung der vorläufigen Kandidatenlisten im Sekretariat des Instituts.

## 3. Schritt

– *spätestens am 15. Januar 2011:*

Versand der Stimmzettel und der zugehörigen Wahlunterlagen an die Wahlberechtigten.

– *15. Februar 2011:*

Fristablauf für den Eingang des ausgefüllten Stimmzettels und der ausgefüllten und unterschriebenen Erklärung im Sekretariat des Instituts.

## 4. Schritt

– *spätestens am 15. März 2011:*

Mitteilung des Wahlergebnisses in der Ausgabe 1/2011 der epi-Information.

Die Regeln für Wahlen zum Rat sind nachstehend abgedruckt.

## Regeln für Wahlen zum Rat

### Regel 1: Wahlen

Die Wahlen zum Rat des Instituts der zugelassenen Vertreter werden gemäß den Vorschriften über die

Errichtung des Instituts und in der nachstehend festgelegten Weise von diesem Institut durchgeführt.

### Regel 2: Wahlberechtigte

#### 2.1

Alle Personen, die in der beim Europäischen Patentamt geführten Liste der zugelassenen Vertreter bei Geschäftsschluss des Europäischen Patentamts in München am letzten Arbeitstag vor dem 15. September desjenigen Jahres eingetragen sind, das dem Jahr vorausgeht, in welchem der nachfolgende Rat sein Amt antritt („Vorjahr der Wahl“), haben das Recht, bei der nächsten ordentlichen Wahl zu wählen und zu kandidieren; andere Personen sind weder aktiv noch passiv wahlberechtigt.

#### 2.2

Die Anzahl der Institutsmitglieder, die bei Geschäftsschluss des Europäischen Patentamts in München am letzten Arbeitstag vor dem 15. September des Vorjahres der Wahl in der Liste der zugelassenen Vertreter eingetragen sind, ist für die Festlegung der Anzahl der in jedem Wahlbezirk zu wählenden Ratsmitglieder gemäß Artikel 7, Absatz 3 der Vorschriften über die Errichtung maßgebend.

### Regel 3: Wahldurchführung

#### 3.1

Jeder Wahlbezirk, dessen Wählerschaft in der direkt vorausgegangenen ordentlichen Wahl zum Rat einheitlich oder nicht-einheitlich gewählt hat, wird in der gleichen Weise wie zum vorhergehenden Rat wählen, es sei denn, ein Wahlbezirk hat vor dem 15. September des Vorjahres der Wahl dem Sekretariat des Instituts gegenüber erklärt, dass er sich nach der in Artikel 7, Absatz 6 der Vorschriften über die Errichtung niedergelegten Weise dafür ausgesprochen habe, die andere Art der Wahl anzuwenden.

#### 3.2

Jeder Wahlbezirk, der während der laufenden Amtszeit des Rates vor dem 15. September des Vorjahres der Wahl geschaffen wurde, hat gemäß Artikel 7, Absatz 4 und 5 der Vorschriften über die Errichtung in der Weise zu wählen, die bei seiner Schaffung zutreffend war, es sei denn, er hat vor dem 15. September des Vorjahres der Wahl dem Sekretariat des Instituts gegenüber erklärt, dass er sich nach der in Artikel 7, Absatz 6 der Vorschriften über die Errichtung niedergelegten Weise dafür

ausgesprochen habe, die andere Art der Wahl anzuwenden.

#### **Regel 4: Wahlausschuss**

##### **4.1**

Der Rat setzt während der letzten Ratssitzung, die vor dem 15. September des Vorjahres der Wahl endet, einen Wahlausschuss ein, der aus drei Institutsmitgliedern, die nicht zur Wahl stehen, besteht. Wenigstens ein Mitglied des Wahlausschusses soll wenn möglich bereits Erfahrung als Mitglied eines Wahlausschusses haben.

##### **4.2**

Die Amtszeit des Wahlausschusses endet erst mit der Einsetzung des nächsten Wahlausschusses vor der nächsten ordentlichen Wahl zum Rat.

##### **4.3**

Artikel 6.2 und 18.2 der Geschäftsordnung gelten auch für den Wahlausschuss.

##### **4.4**

Der Wahlausschuss hat bei der Wahl, für die er eingesetzt worden ist, die Einhaltung der anzuwendenden Vorschriften zu überwachen. Er hat insbesondere die gesamte Vorbereitung der Wahl, das Öffnen der Umschläge und das Auszählen der Stimmzettel zu überwachen, in Zweifelsfällen zu entscheiden, Losentscheidungen zu treffen, wann immer es diese Regeln erfordern, und über die Wahl dem Präsidenten des Rates schriftlich zu berichten.

##### **4.5**

Der Wahlausschuss tritt jeweils frühestens eine Woche, spätestens zwei Wochen nach den in Regeln 6.5 und 9.5 genannten Daten zusammen.

#### **Regel 5: Vorbereitung der Wahl**

Sobald wie möglich nach dem 15. September und spätestens am 1. Oktober des Vorjahres der Wahl hat das Institut jedem Wahlberechtigten an seine Adresse gemäß der in Regel 2 genannten Liste ein Formular zur Vorbereitung der Wahl zum Rat (Wahlvorschlag), mit dem er Kandidaten vorschlagen kann, zu übersenden.

#### **Regel 6: Wahlvorschlag**

##### **6.1**

Jeder Wahlberechtigte kann auf seinem Wahlvorschlag nur für die Wahl in seinem eigenen einheitlichen Wahlbezirk beziehungsweise in seiner eigenen Gruppe seines nicht-einheitlichen Wahlbezirks sich selbst und/oder einen oder mehrere andere Institutsmitglieder, die einem beliebigen Wahlbezirk angehören können und die genau mit Name und Geschäftssitz oder Arbeitsplatz zu bezeichnen sind, als Kandidaten vorschlagen.

##### **6.2**

Ein Wahlberechtigter darf auf seinem Wahlvorschlag nicht mehr Personen als Kandidaten vorschlagen als Ratsmitglieder für seinen eigenen einheitlichen Wahlbezirk beziehungsweise für seine eigene Gruppe seines nicht-einheitlichen Wahlbezirks zugelassen sind. Überzählige Vorschläge werden im Wahlvorschlag, vom Ende beginnend, vom Wahlausschuss gestrichen.

##### **6.3**

Vorgeschlagene Personen, die nur als stellvertretendes Ratsmitglied gewählt werden wollen, sind entsprechend zu bezeichnen.

##### **6.4**

Der Wahlberechtigte bestätigt mit seiner Unterschrift auf seinem Wahlvorschlag, dass jede von ihm vorgeschlagene Person mit ihrer Nominierung einverstanden ist und eine etwaige Wahl annehmen wird.

##### **6.5**

Der Vorschlag eines Wahlberechtigten ist nur gültig, wenn sein von ihm unterschriebener Wahlvorschlag spätestens am 1. November des Vorjahres der Wahl beim Sekretariat des Instituts eingeht.

#### **Regel 7: Kandidatenlisten**

##### **7.1**

Der Wahlausschuss erstellt aufgrund der Wahlvorschläge gemäß Regel 6 für jeden einheitlichen Wahlbezirk und für jede Gruppe jedes nicht-einheitlichen Wahlbezirks eine vorläufige Liste der von ihm zur Wahl zugelassenen Kandidaten.

##### **7.2**

Das Institut sendet spätestens am 1. Dezember des Vorjahres der Wahl jeder zur Wahl vorgeschlagenen Person jede vom Wahlausschuss erstellte vorläufige Kandidatenliste, für die diese Person vorgeschlagen worden ist, unabhängig davon, ob diese Person auf der vorläufigen Kandidatenliste aufgeführt ist oder nicht.

##### **7.3**

Nach dem Versand der vorläufigen Kandidatenlisten kann jede vorgeschlagene Person bis spätestens 10. Dezember (Eingang beim Sekretariat des Instituts) des Vorjahres der Wahl die Änderung der vorläufigen Kandidatenlisten schriftlich beantragen.

##### **7.4**

Der Wahlausschuss erstellt nach Prüfung etwaiger Änderungsanträge die endgültigen Kandidatenlisten bis spätestens 15. Dezember.

#### **Regel 8: Kandidaten**

Alle Kandidaten, die vom Wahlausschuss gemäß Regel 7.4 zur Wahl zugelassen sind, werden ungeachtet ihrer Anzahl zur Wahl gestellt.



## Regel 9: Stimmzettel und andere Wahlunterlagen

### 9.1

Die Wahl zum Rat des Instituts wird durch Briefwahl ausgeübt. Die Stimmzettel und die zugehörigen Wahlunterlagen werden vom Institut bis spätestens 15. Januar der Wahljahres an die Wahlberechtigten zur Post gegeben.

### 9.2

In jedem nicht-einheitlichen Wahlbezirk erhält jeder Wahlberechtigte zwei Stimmzettel unterschiedlicher Farbe, von denen jeder für eine der beiden Gruppen dieses Wahlbezirks gilt und von denen der Wähler nur den für seine eigene Gruppe auszufüllen hat. In jedem einheitlichen Wahlbezirk erhält jeder Wahlberechtigte einen einzigen, für diesen Wahlbezirk geltenden Stimmzettel in einer dritten Farbe. Jeder Wahlberechtigte erhält zur Rücksendung des Stimmzettels einen Umschlag, der die Identität des versendenden Wählers nicht erkennen lässt und beiderseits wenigstens eine Öffnung aufweist, die die Farbe des Stimmzettels, aber nicht die Stimmabgabe von außen erkennen lässt.

### 9.3

Jeder Stimmzettel gibt den einheitlichen Wahlbezirk oder die Gruppe des nicht-einheitlichen Wahlbezirks, zu dem beziehungsweise zu der der Wahlberechtigte gehört, und die Gesamtzahl der ordentlichen und stellvertretenden Ratsmitglieder dieses Wahlbezirks beziehungsweise dieser Gruppe an. Er führt alle Kandidaten auf, die für diesen Wahlbezirk beziehungsweise diese Gruppe zur Wahl gestellt werden, und gibt gegebenenfalls für jeden Kandidaten an, ob er im gegenwärtigen Rat ein ordentliches oder ein stellvertretendes Ratsmitglied ist. Falls ein Kandidat eine Wahl nur als stellvertretendes Ratsmitglied anzunehmen bereit ist, ist dies auf dem Stimmzettel angegeben. Jeder Stimmzettel hat den folgenden Text aufzuweisen: *„Die Stimmabgabe für einen Kandidaten ist nur gültig, wenn der Wähler diese Stimmabgabe auf seinem Stimmzettel eindeutig erkennbar gemacht hat, beispielsweise durch Anzeichnen des Namens oder durch Streichen mindestens eines anderen Namens.“*

### 9.4

Jeder Wahlberechtigte erhält mit dem Stimmzettel oder den Stimmzetteln eine zu unterschreibende Erklärung, dass er selbst den Stimmzettel ausgefüllt hat. Jeder Wähler in einem nicht-einheitlichen Wahlbezirk hat auf der Erklärung zusätzlich anzugeben, ob er zu der Gruppe der freiberuflich Tätigen oder ob er zu der Gruppe der anderweitig Tätigen gehört, und zu versichern, dass er nur den für seine eigene Gruppe zutreffenden Stimmzettel zurücksendet. Wird ein Wähler von einer oder mehreren Personen beschäftigt, die selbst freiberuflich tätig sind, so gilt auch diese Tätigkeit als freiberuflich. Der Wähler darf nur eine Art der Tätigkeit angeben. Der Wähler hat seine ordnungsgemäß ausgefüllte Erklärung gemeinsam mit dem zugehörigen Stimmzettel, der sich

in dem Rücksendeumschlag befinden muss, dem Sekretariat des Instituts zurückzusenden.

### 9.5

Die Stimmen eines Wählers werden nur gezählt, wenn sein Stimmzettel gemeinsam mit seiner vollständig ausgefüllten und von ihm unterschriebenen Erklärung oder einer von ihm unterschriebenen Kopie davon spätestens am 15. Februar des Wahljahres beim Sekretariat des Instituts eingeht.

## Regel 10: Stimmabgabe

Der Wähler hat seine Stimmen entsprechend der Anweisung auf dem Stimmzettel gemäß dem letzten Satz der Regel 9.3 abzugeben. Kein Wähler kann auf seinem Stimmzettel mehr Kandidaten gültig wählen als er insgesamt ordentliche und stellvertretende Mitglieder des Rates wählen kann. Überzählige Kandidaten werden, vom Ende beginnend, vom Wahlausschuss gestrichen.

## Regel 11: Mängel der Stimmzettel

### 11.1

Stimmzettel, die den Willen des Wählers nicht eindeutig erkennen lassen oder denen nicht die ausgefüllte, unterschriebene und datierte Erklärung oder eine Kopie davon mit Originalunterschrift beigelegt ist oder die nicht den Angaben auf der Erklärung entsprechen, sind ungültig.

### 11.2

Bezeichnet ein Wähler auf seinem Stimmzettel einen Kandidaten mehr als einmal, so wird der Kandidat trotzdem nur einmal gezählt. Hinzugefügte Namen von Nicht-Kandidaten und Bemerkungen werden vom Wahlausschuss gestrichen. Die Gültigkeit des Stimmzettels bleibt davon unberührt.

## Regel 12: Gewählte Mitglieder des Rates

### 12.1

Die Anzahl der Stimmen, die auf die Kandidaten entfallen, legt die Reihenfolge der Kandidaten fest, aus der sich ergibt, welche Kandidaten als ordentliche und welche als stellvertretende Mitglieder des Rates gewählt sind. Haben zwei oder mehr Kandidaten eine gleiche Stimmenzahl erhalten, so wird die Reihenfolge vom Wahlausschuss durch das Los entschieden.

### 12.2

Erhält ein Kandidat in zwei oder mehr einheitlichen Wahlbezirken und/oder Gruppen nicht-einheitlicher Wahlbezirke eine Stimmenzahl, die ausreicht, als ordentliches und/oder stellvertretendes Ratsmitglied in jedem dieser Wahlbezirke oder jeder dieser Gruppen gewählt zu sein, so wird das Institut ihn so bald wie möglich hierüber informieren. Der Kandidat muss dann dem Sekretariat des Instituts umgehend mitteilen, in welchem Wahlbezirk oder in welcher Gruppe er ordentliches beziehungsweise stellvertretendes Ratsmitglied werden

möchte. Versäumt er dies, wird die Frage vom Wahlausschuss durch das Los entschieden.

### **Regel 13: Wahlergebnis**

Das Ergebnis der Wahl wird vom Institut bis spätestens 15. März des Wahljahres den Institutsmitgliedern schriftlich mitgeteilt. Diese Mitteilung enthält auch die Angabe der Stimmenzahl, die die Kandidaten erhalten haben, und das Resultat etwaiger Losentscheide.

### **Regel 14: Einsprüche**

#### **14.1**

Institutsmitglieder, die gegen das Wahlergebnis Einwände erheben möchten, müssen ein entsprechendes Rechtsbegehren mit Begründung schriftlich fristgerecht beim Sekretariat des Instituts einreichen, wobei die Frist bei einer ordentlichen Wahl am 29. März des Wahljahres endet und das Fristende bei allen Nachwahlen vom Vorstand des Rates festgesetzt wird. Ein Rechtsbegehren, dem keine Begründung beigelegt ist, und ein solches, das nach Fristende eingeht, wird nicht berücksichtigt.

#### **14.2**

Der Präsident des Rates ernennt unverzüglich nach Eingang eines ordnungsgemäßen Rechtsbegehrens einen Wahl-Einspruchsausschuss, der aus drei Institutsmitgliedern besteht, die keine Kandidaten zur durchgeführten Wahl gewesen sind und keine Mitglieder des Wahlausschusses sind.

#### **14.3**

Die Amtszeit der Mitglieder des Wahl-Einspruchsausschusses beginnt mit ihrer Ernennung und endet mit der Erledigung der Aufgabe, für die sie ernannt worden sind. Artikel 6.2 und 18.2 der Geschäftsordnung gelten auch für den Wahl-Einspruchsausschuss. Der Wahl-Einspruchsausschuss wird den Einspruch gemäß seiner vom Rat bestimmten Zuständigkeit prüfen.

#### **14.4**

Wenn die Art des Einspruchs eine Nachwahl oder eine neue Wahl erfordert, sind die Regeln für die Nachwahl oder neuen Wahl soweit wie möglich die gleichen wie

die zu ordentlichen Ratswahlen; soweit solche Regeln nicht anwendbar sind, werden vom Vorstand des Rates geeignete Regeln aufgestellt.

### **Regel 15: Fristen**

#### **15.1**

Das Sekretariat des Instituts hat alle bei ihm eingehenden Wahlunterlagen mit einem das Eingangsdatum aufweisenden Stempel zu versehen.

#### **15.2**

Vorbehaltlich der Regeln 15.3, 15.4 und 15.5 werden Unterlagen, die nach einem in diesen Regeln für Wahlen zum Rat festgelegten Datum beim Sekretariat des Instituts eingehen, nicht berücksichtigt.

#### **15.3**

Fällt das Ende einer Frist, die von einem Wahlberechtigten oder Kandidaten einzuhalten ist, auf einen Tag, an dem das Sekretariat des Instituts geschlossen ist, so endet die entsprechende Frist am ersten darauf folgenden Arbeitstag des Sekretariats des Instituts.

#### **15.4**

Wenn ein Wähler für den Wahlausschuss beziehungsweise den Wahl-Einspruchsausschuss zufriedenstellend nachweisen kann, dass er ein Schriftstück gemäß diesen Regeln zumindest acht Tage vor Ablauf einer Frist für den Eingang dieses Schriftstückes auf dem besten normalen Postweg, der zur Verfügung steht, an das Sekretariat des Instituts abgesandt hat, so wird dieses Schriftstück nach Eingang beim Sekretariat des Instituts als fristgerecht eingegangen angesehen, wenn zur Zeit des Eingangs andere Umstände eine Berücksichtigung dieses Schriftstückes noch erlauben.

#### **15.5**

Wenn die fristgerechte Erfüllung irgendeiner Bestimmung dieser Regeln nach Meinung des Wahlausschusses beziehungsweise des Wahl-Einspruchsausschusses durch außerhalb der Macht des Wahlberechtigten oder Kandidaten gelegene Umstände unmöglich wird, so kann der Wahlausschuss beziehungsweise der Wahl-Einspruchsausschuss anordnen, dass die Erfüllung zu einem anderen Termin angenommen werden wird.

## Election to the Council of the Institute

At the beginning of next year, the Council of the Institute is due to be elected for its new term.

We would like to inform you of the mailing dates of the documents which have to be completed as well as of the deadlines for receiving the completed documents at the Secretariat of the Institute in Munich.

### 1st step:

– *by 1<sup>st</sup> October 2010 at the latest:*

Mailing of the nomination form for the nomination of candidates to the members of the Institute.

– *by 1<sup>st</sup> November 2010:*

Deadline for receiving the completed nomination form at the Secretariat of the Institute.

### 2nd step

– *by 1<sup>st</sup> December 2010 at the latest:*

Mailing of the provisional lists of candidates to the persons nominated for election.

– *by 10<sup>th</sup> December 2010:*

Deadline for receiving requests in writing for corrections of the provisional lists at the Secretariat of the Institute.

### 3rd step

– *by 15<sup>th</sup> January 2011 at the latest:*

Mailing of the ballot papers and related documents to the electors.

– *by 15<sup>th</sup> February 2011:*

Deadline for receiving the completed ballot paper together with the completed and signed declaration form at the Secretariat of the Institute.

### 4th step

– *by 15<sup>th</sup> March 2011 at the latest:*

Publication of the results of the election in epi Information 1/2011.

The Rules for election of Council are published hereafter.

## Rules for Election of Council

### Rule 1: Elections

Elections to the Council of the Institute of Professional Representatives are carried out by this Institute, in accordance with the Founding Regulation and in the manner laid down below.

### Rule 2: Electors

#### 2.1

All persons entered in the list of Professional Representatives maintained by the European Patent Office at the close of business of the European Patent Office in Munich on the last working day before 15th September of the year preceding the year in which the succeeding Council will take office („pre-election year“) shall be electors having the right to vote and to be candidates in the next ordinary election for the succeeding Council, and no other person.

#### 2.2

The number of members of the Institute entered in the list of Professional Representatives at the close of business of the European Patent Office in Munich on the last working day before 15th September of the pre-election year shall be decisive for determining the number of Council members to be elected in each constituency, according to Article 7, paragraph 3 of the Founding Regulation.

### Rule 3: Voting

#### 3.1

Every constituency which voted unitarily or non-unitarily in the immediately preceding ordinary election to the Council and not having indicated to the Secretariat of the Institute before 15th September of the pre-election year that it has decided, in the manner envisaged by Article 7, paragraph 6 of the Founding Regulation, to adopt the other method of voting, shall vote in the same manner in the election of the succeeding Council.

#### 3.2

Every constituency created during the current term of office of the Council and before 15th September of the pre-election year shall vote in the manner that was appropriate at its creation, pursuant to Article 7, paragraphs 4 and 5, of the Founding Regulation, unless it has indicated before 15th September of the pre-election year to the Secretariat of the Institute that it has decided, in the manner envisaged by Article 7, paragraph 6, of the Founding Regulation, to adopt the other manner of voting.

### Rule 4: Electoral Committee

#### 4.1

During the last Council Meeting, before the 15th September of the pre-election year, the Council shall set up an Electoral Committee consisting of three members of the Institute who shall not stand for election, and at least one of whom should, if possible, have experience within a previous Electoral Committee.

## 4.2

The term of the Electoral Committee shall continue until the setting up of the next Electoral Committee for the next ordinary election of Council.

## 4.3

Articles 6.2 and 18.2 of the By-Laws are also applicable to the Electoral Committee.

## 4.4

For the election of Council for which the Electoral Committee has been set up, the Electoral Committee shall supervise conformity with the applicable Rules. The Electoral Committee shall in particular supervise all the steps relating to preparation for the election, the opening of the envelopes, the counting of the votes, shall decide in cases of doubt, shall draw lots whenever required by these Rules, shall declare the result of the election, and shall prepare a written report to the President of the Council on that election.

## 4.5

The Electoral Committee shall meet not before one week from and two weeks later than the respective dates mentioned in Rules 6.5 and 9.5.

### Rule 5: Preparation for the Election

As soon as possible after 15th September and no later than 1st October of the pre-election year, the Institute shall send to each elector at his address as in the list referred to in Rule 2 a nomination form in preparation for the election of Council in which he may make nominations for candidates for election to Council.

### Rule 6: Nomination

## 6.1

Only for his own unitary constituency or group of a non-unitary constituency, every elector can nominate himself and/or one or more other member(s) of the Institute, including those from another constituency, as candidate(s) for election, providing he identifies him/them by name and place of business or employment on his nomination form.

## 6.2

An elector shall not nominate on his nomination form more persons for election than the maximum number of Council members that is determined for his own unitary constituency or his own group of his non-unitary constituency. Nomination(s) beyond the determined number shall be struck from his nomination form from the end towards the beginning by the Electoral Committee.

## 6.3

A nominated person, who is only prepared to stand as a substitute, shall be so indicated.

## 6.4

An elector who has signed his nomination form thereby confirms that each nominee accepts his nomination and election, if elected.

## 6.5

To be valid, a signed nomination form shall be received by the Secretariat of the Institute no later than 1st November of the pre-election year.

### Rule 7: Lists of candidates

## 7.1

For each unitary constituency and each group of each non-unitary constituency, the Electoral Committee shall prepare from the persons nominated, according to the provisions of Rule 6, a provisional list of candidates for election.

## 7.2

No later than 1st December of the pre-election year, the Institute shall send to each person nominated for election to Council the provisional list(s) drawn up by the Electoral Committee for the or each constituency for which he has been nominated. Persons whose nomination was disregarded shall also receive those provisional list(s).

## 7.3

After the provisional list(s) has/have been sent, any person nominated may request in writing correction of such provisional list(s). Any such request shall be received by the Secretariat of the Institute at the latest by 10th December of the pre-election year.

## 7.4

The Electoral Committee shall consider any such request and shall then draw up final lists of candidates for election until 15th December.

### Rule 8: Candidates

All candidates appearing on final lists drawn up according to Rule 7.4 shall be put forward for election, regardless of their number.

### Rule 9: Ballot Papers and related documents

## 9.1

The election of the Council shall be carried out by postal vote. At the latest by the 15 January of the election year, the Institute shall send ballot papers and related documents by post to the electors.

## 9.2

In every non-unitary constituency each elector will receive two ballot papers of different colour, applicable respectively to the two groups of that constituency, of which he will complete only the one applicable to his own group. In every unitary constituency each elector

will receive a single ballot paper applicable to that constituency and of a third colour. Each elector will receive an envelope for returning the ballot paper, suitable for concealing the returning elector's identity, and with at least one opening on both sides, which allows identification of the ballot paper by colour, but not the content of the ballot paper.

### 9.3

Each ballot paper will indicate the unitary constituency or the group of a non-unitary constituency for which that ballot paper is valid, and the total number of representatives and substitutes for that constituency or group. The ballot paper will indicate all the candidates standing for election to the respective constituency or group of a non-unitary constituency, and, where applicable, for each of them whether he is a representative or substitute of the current Council, and whether a candidate wishes only to stand for election as a substitute. Each ballot paper must include the following text: *„The vote for a candidate shall only be valid when the elector makes it clear on his ballot paper that he has voted for that candidate, particularly by putting a sign or mark against the name of that candidate, or by striking out the name(s) of (an) other candidate(s).“*

### 9.4

Each elector will receive with the ballot paper(s) a declaration for the elector to declare that he himself has completed the ballot paper. In addition, each elector in a non-unitary constituency shall on the declaration declare that he is a member of the group in private practice, or in the group of another capacity, and that he has only returned the ballot paper applicable to his own group. Employment in a private practice firm shall be considered as being in the group in private practice. An elector is permitted to indicate on the declaration only one kind of practice. The elector shall return the duly completed declaration, together with the related ballot paper, which ballot paper must be in the envelope provided, to the Secretariat of the Institute.

### 9.5

The votes of the elector will only be counted if his ballot paper together with his completed and signed declaration, or a photocopy thereof (provided the signature is original), is received by the Secretariat of the Institute no later than 15 February of the election year.

## Rule 10: Voting

An elector shall vote as directed on the ballot paper according to the last sentence of Rule 9.3. No elector may validly vote on his ballot paper for a number of candidates exceeding the determined number of representatives and substitutes, taken together, for whom he may vote. Votes cast exceeding the determined number will be struck from a ballot paper from the end towards the beginning by the Electoral Committee.

## Rule 11: Ballot Deficiencies

### 11.1

Ballot papers which do not clearly allow a determination of the intention of the elector, or which are not accompanied by the completed, signed and dated declaration, or by a photocopy thereof on which the signature is original, or which do not correspond with the declaration, are null and void.

### 11.2

If an elector votes on his ballot paper more than once for a candidate, that candidate will be counted only once. Added names of persons who are not candidates and remarks shall be deleted by the Electoral Committee without prejudice to the validity of the ballot paper.

## Rule 12: Elected Members of Council

### 12.1

The number of votes received by the candidates determines whether they are elected either as representatives or as substitutes, and in what order. If an equal number of votes is received by two or more candidates, their order will be decided by lots drawn by the Electoral Committee.

### 12.2

If a candidate receives in two or more unitary constituencies and/or groups of non-unitary constituencies a number of votes sufficient for being elected, as a representative and/or as a substitute, in each of those constituencies or groups, the Institute shall inform him accordingly as soon as possible, and he must then promptly advise the Secretariat of the Institute in which one he chooses to become a representative or a substitute, as the case may be, failing which the question will be decided by lots drawn by the Electoral Committee.

## Rule 13: Election results

At the latest by 15th March of the election year, the Institute shall send the result of the election by post to its members, indicating the number of votes received by all candidates and the result of any drawing of lots, if applicable.

## Rule 14: Objections

### 14.1

Members of the Institute wishing to object against the election result shall submit their written requests with a reasoned statement to reach the Secretariat of the Institute at the latest by a date which for an ordinary election is 29th March of the election year and for any by-election will be set by the Board of the Council. Any request without a reasoned statement will not be taken into consideration, neither will a request reaching the Secretariat of the Institute after the respective date be taken into consideration.



## 14.2

After a correctly made request has been received by the Secretariat of the Institute, the President of the Council shall promptly designate an Electoral Objections Committee consisting of three members of the Institute who were not candidates in the disputed election and who are not members of the Electoral Committee.

## 14.3

The term of the Electoral Objections Committee shall continue until the completion of examination of the objections for which it was designated. Articles 6.2 and 18.2 of the By-Laws are applicable to the Electoral Objections Committee. The Electoral Objections Committee shall examine the objections in conformity with terms of reference fixed for it by the Council.

## 14.4

If the nature of the objections requires a by-election or new election, the Rules governing that election shall as far as possible be the same as those governing ordinary elections to Council and where those Rules are not applicable, Rules will be set by the Board of the Council.

**Rule 15: Time Limits**

## 15.1

The Secretariat of the Institute shall stamp all papers concerning the elections received by the Institute with a stamp giving the date of receipt.

## 15.2

Any paper reaching the Institute after any respective date set by the Rules for election of Council shall be ignored, excepting as provided for in Rules 15.3, 15.4 and 15.5 hereafter.

## 15.3

If any time limit which must be observed by an elector or candidate falls on a day on which the Secretariat of the Institute is closed, that time limit shall extend until the first working day of the Secretariat of the Institute thereafter.

## 15.4

If an elector can prove to the satisfaction of the Electoral Committee or the Electoral Objections Committee respectively that he posted any paper referred to in these Rules to the Secretariat of the Institute by the best normal postal service available at least eight days before a time limit for receipt of that paper, the paper shall, after receipt by the Secretariat of the Institute, be deemed to have been received in time, if at that time of receipt other circumstances still permit account to be taken of that paper.

## 15.5

If compliance with any provision of these Rules by the date set is, in the opinion of the Electoral Committee or the Electoral Objections Committee respectively, rendered impossible by circumstances outside the elector's or candidate's control, the Electoral Committee or the Electoral Objections Committee respectively may rule that compliance by another date will be accepted.

## Election au Conseil de l'Institut

Au début de l'année prochaine, le Conseil de l'Institut sera renouvelé pour un nouveau mandat.

Nous vous informons des dates d'envoi des documents à remplir et des dates auxquelles ces documents devront être retournés au secrétariat de l'Institut à Munich.

**1ère étape**

– *au plus tard le 1er octobre 2010:*

Envoi du formulaire de candidature pour la nomination de candidats aux membres de l'Institut.

– *1er novembre 2010:*

Date limite de réception du formulaire de candidature au secrétariat de l'Institut.

**2ème étape**

– *au plus tard le 1er décembre 2010:*

Envoi des listes provisoires de candidats aux personnes dont la candidature a été proposée.

– *10 décembre 2010:*

Date limite de réception, au secrétariat de l'Institut, de toute requête écrite visant à apporter une correction sur les listes provisoires de candidats.

**3ème étape**

– *au plus tard le 15 janvier 2011:*

Envoi des bulletins de vote et documents annexés aux électeurs.



– 15 février 2011:

Date limite de réception du bulletin de vote dûment rempli ainsi que du formulaire de déclaration, dûment rempli et signé, au secrétariat de l'Institut.

#### 4ème étape

– au plus tard le 15 mars 2011:

Communication des résultats des élections dans epi Information 1/2011.

Les Règles pour l'élection au Conseil sont publiées ci-après.

### Règles pour les élections au Conseil

#### Règle 1: Elections

Les élections au Conseil de l'Institut des mandataires agréés sont organisées par cet Institut en application du Règlement de création et de la manière précisée ci-dessous.

#### Règle 2: Electeurs

##### 2.1

Toute personne qui est inscrite sur la liste des mandataires agréés, tenue par l'Office européen des brevets, à l'heure de fermeture de l'Office européen des brevets à Munich le dernier jour ouvrable avant le 15 septembre de l'année précédant celle au cours de laquelle le nouveau Conseil entrera en exercice („année pré-électorale“), aura la qualité d'électeur ayant le droit de voter et d'être candidat pour la prochaine élection ordinaire au nouveau Conseil, et ce à l'exclusion de toute autre personne.

##### 2.2

Le nombre des membres à l'Institut inscrits sur la liste des mandataires agréés à l'heure de fermeture de l'Office européen des brevets à Munich le dernier jour ouvrable avant le 15 septembre de l'année pré-électorale, sera pris en considération pour fixer le nombre de membres du Conseil qui seront élus dans chaque circonscription, conformément à l'article 7, paragraphe 3 du Règlement de création.

#### Règle 3: Vote

##### 3.1

Toute circonscription ayant voté suivant le système à collège unique ou à double collège lors des élections ordinaires immédiatement précédentes au Conseil, et n'ayant pas indiqué au Secrétariat de l'Institut avant le 15 septembre de l'année pré-électorale que, en vertu de l'Article 7, paragraphe 6 du Règlement de création, elle a décidé d'adopter l'autre système, devra voter suivant le précédent système aux élections du nouveau Conseil.

##### 3.2

Toute circonscription créée avant le 15 septembre d'une année pré-électorale pendant la durée d'exercice du Conseil devra voter suivant le système applicable à la date de sa création en vertu de l'Article 7, paragraphe 4 et 5 du Règlement de création, à moins qu'elle n'ait indiqué au Secrétariat de l'Institut avant le 15 septembre de l'année pré-électorale que, conformément à l'Article 7, paragraphe 6 du Règlement de création, elle adoptera l'autre système.

### Règle 4: Commission Electorale

##### 4.1

Lors de la dernière réunion du Conseil prenant fin avant le 15 septembre de l'année pré-électorale, le Conseil devra désigner une Commission Electorale constituée de trois membres de l'Institut qui ne se présentent pas aux élections. L'un d'entre eux au moins devrait avoir si possible une expérience antérieure au sein d'une Commission Electorale.

##### 4.2

L'exercice de la Commission Electorale se poursuit jusqu'à la mise en place d'une nouvelle Commission Electorale en vue de la prochaine élection ordinaire du Conseil.

##### 4.3

Les dispositions de l'Article 6.2 et 18.2 du Règlement Intérieur sont aussi applicables à la Commission Electorale.

##### 4.4

Pour l'élection pour laquelle elle a été désignée, ladite Commission veillera au respect des règles en vigueur. Elle supervisera toutes les tâches préparatoires afférentes à l'élection, le dépouillement du scrutin, tranchera en cas de doute et effectuera en tant que de besoin les tirages au sort prévus par les présentes règles; elle annoncera les résultats de l'élection et établira un compte-rendu de celle-ci à l'attention du Président du Conseil.

##### 4.5

La Commission Electorale se réunit au plus tôt une semaine après et au plus tard deux semaines après les dates visées aux Règles 6.5 et 9.5.

### Règle 5: Préparation de l'élection

Dès que possible, après le 15 septembre de l'année pré-électorale, mais au plus tard le 1er octobre de cette même année, l'Institut enverra à chaque électeur, à son adresse indiquée sur la liste visée à la Règle 2, un formulaire de candidature destiné à la préparation de l'élection du Conseil, grâce auquel chaque électeur peut soumettre des candidatures.

## Règle 6: Proposition de candidatures

### 6.1

Exclusivement pour sa circonscription à collège unique, ou son propre groupe dans le cas d'une circonscription à double collège, tout électeur peut soumettre sa propre candidature et/ou celle d'un ou de plusieurs autres membres de l'Institut, même provenant d'une autre circonscription. Les candidats doivent être dûment identifiés sur le formulaire de candidature par leur nom et leur lieu d'établissement ou d'emploi.

### 6.2

Un électeur ne doit pas soumettre sur son formulaire de candidature plus de candidatures à l'élection qu'il n'y a de sièges disponibles de membres du Conseil dans sa propre circonscription si celle-ci est à collège unique, ou son propre groupe si la circonscription est à double collège. Au-delà du nombre de sièges disponibles, les candidatures en trop seront biffées du formulaire de candidature de bas en haut par la Commission Electorale.

### 6.3

Les personnes dont la candidature est proposée et qui sont disposées à siéger en tant que membres suppléants uniquement, doivent être identifiées en tant que telles.

### 6.4

L'électeur qui a formulé une proposition de candidatures confirme par sa signature sur le formulaire de candidature que chaque candidat accepte sa candidature et son élection, le cas échéant.

### 6.5

Pour être valable, le formulaire de candidature doit parvenir dûment signé au secrétariat de l'Institut au plus tard le 1er novembre de l'année pré-électorale.

## Règle 7: Listes des candidats

### 7.1

Pour chaque circonscription à collège unique et pour chaque groupe des circonscriptions à double collège, la Commission Electorale établit à partir des propositions de candidatures une liste provisoire de candidats conformément aux dispositions de la Règle 6.

### 7.2

Au plus tard le 1er décembre de l'année pré-électorale, l'Institut transmet à chaque personne dont la candidature a été proposée la ou les listes provisoires qui la concernent, et ce dans toutes les circonscriptions à collège unique et tous les groupes des circonscriptions à double collège pour lesquels sa candidature a été proposée. L'Institut fait également parvenir ces listes aux personnes dont le nom n'a pas été retenu par la Commission Electorale pour y figurer.

### 7.3

Après que les listes provisoires aient été transmises, toute personne dont la candidature a été proposée peut demander leur correction par écrit. Une requête à cette fin, doit parvenir au secrétariat de l'Institut au plus tard le 10 décembre de l'année pré-électorale.

### 7.4

La Commission Electorale statue sur les requêtes en correction et établit ensuite les listes définitives de candidats à l'élection jusqu'au 15 décembre.

## Règle 8: Candidats

Tous les candidats dont les noms apparaissent sur les listes définitives visées à la Règle 7.4 sont présentés aux élections, au mépris de leur nombre.

## Règle 9: Bulletins de vote et documents annexés

### 9.1

L'élection au Conseil s'effectue par correspondance postale. Au plus tard le 15 janvier de l'année de l'élection, l'Institut adresse les bulletins de vote et documents annexés par voie postale aux électeurs.

### 9.2

Dans toute circonscription à double collège, chaque électeur recevra deux bulletins de vote de couleur distincte, respectivement valables pour chacun des groupes de cette circonscription, et il ne devra remplir que le bulletin valable pour son propre groupe. Dans toute circonscription à collège unique, chaque électeur recevra un seul bulletin de vote valable pour cette circonscription, dans une troisième couleur. Chaque électeur recevra une enveloppe permettant de remettre le bulletin de vote sans révéler l'identité de l'électeur, et comportant au moins une ouverture sur les deux faces permettant de reconnaître la couleur du bulletin de vote mais non d'identifier son contenu.

### 9.3

Chaque bulletin de vote mentionne pour quelle circonscription à collège unique ou quel groupe d'une circonscription à double collège il est valable, ainsi que le nombre total de l'ensemble des représentants titulaires et suppléants pour cette circonscription ou ce groupe. Il indiquera en outre tous les candidats qui sont présentés dans la circonscription à collège unique ou le groupe de la circonscription à double collège considérés, et le cas échéant, pour chacun d'entre eux, s'il est représentant titulaire ou suppléant au sein du Conseil précédent, et si le candidat souhaite son élection uniquement en qualité de membre suppléant. Chaque bulletin de vote comprend en outre la mention suivante: *„Le vote en faveur d'un candidat sera réputé valable uniquement lorsque l'électeur montre clairement sur le bulletin de vote qu'il a voté pour ce candidat, notamment à l'aide d'un signe ou d'une marque en regard de son nom, ou en biffant les noms d'un ou des autres candidats qu'il ne souhaite pas élire.“*

#### 9.4

Chaque électeur reçoit avec le ou les bulletins de vote une déclaration au moyen de laquelle il déclare avoir rempli lui-même le bulletin de vote. Pour les circonscriptions à double collège, chaque électeur indique en outre s'il appartient au groupe de la profession libérale ou s'il exerce à tout autre titre, et qu'il renvoie seulement le bulletin de vote de son propre groupe. Si un membre exerce son activité auprès d'un employeur qui exerce lui-même à titre libéral, cette dernière sera également considérée comme relevant de la profession libérale. Un électeur n'est autorisé à mentionner qu'un seul titre d'exercice. L'électeur renvoie au Secrétariat de l'Institut la déclaration, dûment remplie, ainsi que le bulletin de vote qui doit être préalablement inséré dans l'enveloppe jointe.

#### 9.5

Le vote d'un électeur ne sera compté que si le bulletin de vote et la déclaration, dûment remplie et signée, ou une photocopie de celle-ci, portant une signature originale, parviennent au Secrétariat de l'Institut au plus tard le 15 février de l'année de l'élection.

### Règle 10: Vote

Chaque électeur doit voter suivant les instructions figurant sur le bulletin de vote, conformément à la dernière phrase de la Règle 9.3. Aucun électeur ne peut valablement marquer sur son bulletin de vote plus de candidats que le nombre total des représentants titulaires et suppléants, pris dans leur ensemble, pour lequel il est autorisé à voter. Au-delà du nombre autorisé, les noms des candidats sont biffés de bas en haut par la Commission Electorale.

### Règle 11: Bulletin nuls

#### 11.1

Sont considérés comme nuls et sans valeur les bulletins de vote qui ne permettent pas de déterminer clairement l'intention de l'électeur, ou ceux qui ne sont pas accompagnés de la déclaration, dûment remplie, signée et datée, ou d'une photocopie de celle-ci portant une signature originale, ainsi que ceux qui ne correspondent pas à la déclaration.

#### 11.2

Si un candidat se voit attribuer plusieurs fois la marque d'un électeur sur un bulletin de vote, celle-ci ne sera prise en compte qu'une seule fois. Les noms additionnels de personnes non-candidates et les remarques seront barrés par la Commission Electorale sans préjudice de la validité du bulletin de vote.

### Règle 12: Membres du Conseil élus

#### 12.1

Le nombre des voix recueilli par les candidats détermine leur ordre d'élection qui détermine si ceux-ci sont élus au

Conseil en tant que représentant titulaire ou en tant que suppléant. Si un nombre égal de voix a été recueilli par deux ou plus de candidats, ces derniers sont départagés par tirage au sort organisé par la Commission Electorale.

#### 12.2

Si un candidat recueille, dans deux ou plus de deux circonscriptions à collège unique et/ou groupes de circonscriptions à double collège, un nombre de voix suffisant pour être élu dans chacun de ces circonscriptions ou groupes, en tant que représentant titulaire et/ou suppléant, l'Institut devra l'en informer dès que possible. Le candidat devra alors indiquer à bref délai au Secrétariat de l'Institut dans quelle circonscription ou quel groupe il choisit de devenir représentant titulaire ou, le cas échéant, suppléant, faute de quoi la question sera tranchée par tirage au sort organisé par la Commission Electorale.

### Règle 13: Résultat de l'élection

Au plus tard le 15 mars de l'année électorale, l'Institut communiquera par écrit le résultat de l'élection à tous les membres, en indiquant le nombre de voix recueillies par chaque candidat et, le cas échéant, le résultat des tirages au sort qui auront été effectués.

### Règle 14: Contestation du résultat

#### 14.1

Les membres de l'Institut désirant contester le résultat d'une élection devront soumettre par écrit une requête au Secrétariat de l'Institut, accompagnée d'un mémoire exposant leurs objections, de manière qu'ils lui parviennent au plus tard le 29 mars de l'année électorale lorsqu'une élection ordinaire est concernée, et, dans le cas d'une élection complémentaire, à une date qui sera fixée par le Bureau du Conseil. Si la requête en contestation parvient au secrétariat de l'Institut après cette date, ou si elle n'est pas accompagnée d'un mémoire exposant les objections soulevées, celle-ci ne sera pas prise en considération.

#### 14.2

Dès la réception de la requête en contestation, le Président du Conseil devra désigner dans les plus brefs délais une Commission des Contestations de l'élection constituée de trois membres de l'Institut qui n'ont pas été candidats dans l'élection contestée, ni membre de la Commission Electorale.

#### 14.3

L'exercice de la Commission des Contestations de l'élection se poursuit jusqu'au complet achèvement de son devoir. Les dispositions des Articles 6.2 et 18.2 du Règlement Intérieur sont applicables à la Commission des Contestations de l'élection. La Commission des Contestations de l'élection devra traiter les contestations conformément à ses attributions fixées par le Conseil.

## 14.4

Si la nature des objections impose une élection complémentaire ou une nouvelle élection, les Règles régissant ces élections seront, autant que possible, les mêmes que celles qui régissent l'élection ordinaire au Conseil, sous réserve de l'application de Règles spécifiques fixées par le Bureau du Conseil.

**Règle 15: Délais**

## 15.1

Le secrétariat de l'Institut pose un cachet d'arrivée portant la date de réception sur tout document relatif aux élections qui arrive au secrétariat de l'Institut.

## 15.2

Tout document arrivant au secrétariat de l'Institut au-delà des dates prescrites par les présentes Règles ne sera pas pris en considération, à l'exception de ceux visés aux Règles 15.3, 15.4 et 15.5 ci-après.

## 15.3

Si le dernier jour d'un délai qui doit être observé par un électeur ou un candidat tombe sur un jour de fermeture

du secrétariat de l'Institut, alors le délai est prorogé jusqu'au jour ouvrable suivant du Secrétariat de l'Institut.

## 15.4

Si un électeur peut prouver de façon convaincante à la Commission Electorale ou la Commission des Contestations de l'élection respectivement qu'il a effectué l'envoi d'un document quelconque prescrit par les présentes Règles par courrier postal à l'adresse du Secrétariat de l'Institut dans les meilleures conditions normales possibles, au moins huit jours avant la date limite de réception de ce document, ce dernier sera considéré à sa réception par le Secrétariat de l'Institut comme ayant été reçu dans le délai fixé si, lors de sa réception, aucune autre circonstance ne s'y oppose.

## 15.5

Si la Commission Electorale ou la Commission des Contestations de l'élection respectivement estime que des circonstances indépendantes de la volonté d'un électeur ou d'un candidat ont empêché ce dernier de respecter l'une quelconques des exigences des présentes Règles à une date fixée, celle-ci peut décider que le respect de cette exigence à une autre date devra être accepté.

## 68th Meeting of Council Strasbourg, 12<sup>th</sup> June 2010

T. Johnson (GB)  
Editorial Committee

The meeting was hastily convened to take the place of the meeting scheduled for April in Dublin, which was cancelled owing to the volcanic ash cloud over Europe that time. CEIPI had helped a great deal in setting up the meeting and with the other organisers, was thanked warmly for excellent arrangements at such short notice.

The meeting was preceded by a pre-meeting – see separate report in this issue.

The Minutes, Decisions and Actions arising from the 67<sup>th</sup> meeting were adopted without substantive amendment.

The Secretary General reported on the Secretariat of the Institute. He noted that the staff complement was one person short, the present staff being at full stretch. The new office manager, Ms Ortlepp had fitted in well and had assumed responsibility for checking on day-to-day finances, and she was also responsible for translating Council minutes into German. Indeed the accounting area had been strengthened by the recent employment of Ms Opatz, temporarily assisted by Ms Kalbe. Ms Monéger continues to be very busy, being responsible

for organisation of Council and Board meetings, secretary of the Editorial Committee, Web-Site updates and translations into French. She was ably assisted by Ms Fromm who in addition has responsibility for Educational and Student matters within the *epi*.

The Secretary General reported that membership had increased to 9536 as a result of accession of San Marino to the EPC. The President of the EPO had yet to nominate delegates from San Marino to the *epi* Council, and for that matter delegates for the Former Yugoslav Republic of Macedonia too, the EPO President having this responsibility to nominate to Council members from new member states on their accession.

The Treasurer emphasised that annual subscriptions could no longer be paid by cheque. This came under a general but extended discussion on *epi* finances and their future handling.

Council elected various new members to committees: Electoral: Mr Heinz Breiter (CH), Mr Markus Müller (CH), and Mr Arni Vilhjalmsón (IS); By-laws: Ms Jasmin Jantschy (BE);

Disciplinary: Mr Luigi Sansone (MT), Mr Gunter Schmalz (MC);

Professional Conduct: Mr Michael Lucey (IE);

EPPC: Mr Zsolt Szentpéteri (HU).

The President reported, listing various meetings he or his representatives had attended since the last Council meeting, mentioning the well-received interview with Dr Geiger of CEIPI (reported in the previous issue of *epi* Information). There was also an extended discussion on the President's paper, which he introduced and explained, on possible re-organisation of Council. The main aim was to reassign responsibility for affairs of the Institute to Council rather than to the Board coupled with the ultimate goal of reducing the size of Council to make it more efficient and cost-effective. As mentioned, this discussion was extensive and no decision was reached, but Council set up an ad hoc committee consisting of Francis Leyder (BE), Chris Mercer (GB), Dieter Speiser (DE), Ms Kaisa Suominen (FI) and Ádám Szentpéteri (HU), the remit of the committee being to consider all the issues raised by the President's proposal with a view to reporting to the next Council meeting (Berlin November, 2010).

The President also referred to the retirement of, and paid tribute to, Dr Carl Eder (CH), a founder member of the Council and of the By-Laws Committee of which he

had been president since its inception. Dr Eder was thanked by Council with warm and prolonged acclamation for all he had done for the Council over the years.

Council noted the importance of the By-Laws committee to the running of the Institute and agreed that members of the committee who are not members of Council should be invited to Council meetings.

The President also reported that Walter Holzer (AT) (past President) had just been appointed an ambassador of CEIPI. He is to be invited to give a presentation on CEIPI at the next Council meeting, particularly as the Institute and CEIPI have agreed to act in concert in matters relating to education. Education being an important plank in *epi*'s agenda, Council approved a proposal from the President to enhance the *epi* profile in new and recent Member States by providing small delegations to visit such states and speak to them in particular on the *epi* and education.

Council also approved amendment of the rules for *epi* studentship, including the raising of the fee for continued studentship from 35 euros to 45 euros. The amended rules are available on the *epi* website.

Council also decided not to amend the *epi* Code of Conduct but did approve a position paper on the EEUPC draft Agreement and another position paper on document CA/162/09 from the EPO on „Procedural Efficiency“.

## Council Pre-Meeting Strasbourg 11 June 2010

T. Johnson (GB)  
Editorial Committee

The meeting took place in the afternoon preceding the 68<sup>th</sup> Council Meeting. About 70 Council members attended to hear presentations on (a) Manual of Best Practise (MBP) and (b) Procedural Efficiency (PE), both EPO initiatives.

- (a) MBP: Tony Tangena and Chris Mercer represent the *epi* at meetings convened by the EPO on this topic. The general aim of MBP as reported by Tony Tangena seems to be to try to increase the efficiency of search, examination and opposition procedures (but not of appeals) at the EPO.

The MBP is proposed to be complementary to the Guidelines. If implemented MBP could have a wide-ranging effect on the way attorneys deal with the EPO and hence with their clients. However the EPO stresses that the EPC and the jurisprudence of the Boards of Appeal will still be deciding. If this is the case, the view was expressed in the Pre-Meeting that there may be no need for the MBP as once it is finalised and published there was the danger that it would become the dominant

feature in proceedings before the EPO. In addition the meeting expressed the view that the *epi* effectively has its own MBP in that the qualifying examination (EQE) imposes a discipline on *epi* members.

Members will be aware of Article 71(3) EPC. The EPO has proposed adding the words „of related bibliographic data“ to the present text. This would effectively mean that the Applicant and thus his attorney, has further work and thus expense in checking. The *epi* view is that this requirement should be cancelled.

The EPO seems to be keen on pushing through their MBP proposal as quickly as possible, with internal approval in 2010 and finalisation of the manual in respect of filing applications, examination, oral proceedings and oppositions in tranches in 2011.

The general mood of the meeting was that our institute should continue to be involved in discussions with the EPO, and that a paper should be produced with background information supporting our point of view, this paper to be sent to National Delegations of the AC.



(b) PE: Ruurd Jorritsma reported on behalf of an ad hoc committee of the *epi* which has been following this initiative of the EPO. The aim of PE is to provide efficiency and quality (of the granting procedure) within the ambit of sustainable finance of the Office. Some of the EPO emphasis is on Rule 71 proceedings, which are complicated as the rule deals with amendments in the last part of the granting procedure, ie amendments to the Druckexemplar by the examiner or applicant. The original proposal, now re-worded was for examiners to be able to make amendments. In Rule 71(2), the word „all“ is proposed to be deleted. The *epi* wants the word re-

instated otherwise grant which provides for spare parts, or some biotech inventions, could be prejudiced.

The meeting was generally of the view that the *epi* should put forward its own view as to what would be helpful for providing procedural efficiency. The meeting proposed that a draft paper should be produced for consideration by the *epi* Board meeting in September. The paper would preferably split the issue into two parts, namely (i) what the *epi* wishes, and (ii) what the EPO seems to wish. This was considered to be a constructive way forward.

## Minutes of EPO/*epi* Biotech Committee Meeting 4<sup>th</sup> November 2009

A. De Clercq (BE)  
Chairwoman

### In Attendance:

Thanos Stamalopoulos (GR)  
Bernd Isert (BI, dir. 2404)  
Uli Thiele (UT, dir. 2403)  
Siobhán Yeats (SY, dir. 2406)  
Victor Kaas (VK, dir. 2401, Munich)  
Enrique Molina Galan (EMG, dir. 1212 – The Hague)  
Sjoerd Hoekstra (SJH, dir. 1223 – The Hague)

Ann De Clercq (AdC) – BE  
Dieter Wächter (DW) – CH  
Bart Swinkels (NL) – BS  
Francisco Bernado Noriega (ES)  
Anne Desaix (AD) – FR  
Arpad Petho (AP) – HU  
Simon Wright (SW) -GB  
Gabriele Leissler-Gerstl (GLG, liaison member of EPPC)  
Thorlakur Jonsson (IS)

### Introduction

#### 1. Stem cells/WARF decision (G2/06)

There was, in the end, no referral to the ECJ. There are still some open questions though, and certain issues remain to be clarified. Not all stem cells are excluded, it is only how they are derived that is key. The description thus becomes more important for this issue. Deposited cell lines will overcome the morality objection, but it is not clear whether where the deposit was made, and whether it is publicly available, is important. The EPO

may try to get guidance from other decisions. It may be enough if the description refers to a cell line (albeit generically). (N.B. Since the meeting there has been a referral to the ECJ by the German courts on the Brustle case).

A more recent Decision (T 522/04) confirmed that derivation of stem cells from embryos was unpatentable (here there was a disclaimer of „not derived from or by destruction of an embryo“ which did not succeed as it contravened Article 123(2) EPC).

#### 2. EBA Referrals G 1/07 & G 2/08 (hearings are scheduled on 20 & 21<sup>st</sup> July 2010)

In the Netherlands there is a public campaign not to patent plants and animals. The EPO will only stay cases if the applicant so requests, and then only if that is the last remaining issue.

#### 3. Rule 71(3) procedure

The EPO would like changes to cater for amendments in the Druckexemplar text requested by the applicant. Worryingly, the future Guidelines may encourage Examiners to make changes.

The EPO wants to streamline the procedure. Only in a few cases does the applicant refute the changes made. Examiners do contact attorneys, and that works well. The EPO's practice seems to that Examiners should only correct minor errors, or only make minor changes to the claims.

Two examples were given by the *epi* of 'rogue' Examiners making significant changes of their own accord;



firstly, deletion of Examples allegedly outside claims (they should instead have been re-labelled as Comparative Examples); and, secondly, wholesale major changes to the description (where the Examiner then refused to enter reversing changes from the applicant under his discretion).

#### 4. *Raising the bar initiatives*

In the reply to a Search Opinion, the EPO will expect a complete response. However, the applicant may have little time after EP phase entry to prepare such a full response, so it may not be as complete as, say, a response filed later during the examination procedure.

Under new Rule 137 there will be a first check by a Formalities officer to see if basis for the amendments made has been indicated. Then the file will go to the Examining Division. The Rule 161 communication is *not* the first communication from the Examining Division.

New Rule 62a. This revised procedure will provide an opportunity for Examiners to clarify the subject matter to be searched, and was originally aimed at computer related cases. The biotech clusters will accept lots of independent claims to different products in the same invention.

#### 5. *Oral Proceedings (OPs)*

A more relaxed procedure to requests for a change in the date was published in the EPOJ in 2009. The EPO will now take into account whether an attorney has other OPs on same day or in the same week. The EPO thinks that attorneys could be able to cope with two OPs in the same week if neither case is complex. The EPO will also generally accept that usually only one attorney is properly able to run the case, and that they cannot be substituted by another attorney, even in the same firm.

The *epi* mentioned a case where the Examiner did not want to go ahead with Oral Proceedings, and wanted to postpone, even though the client wanted to go ahead. The Examiner also made an A.124 request for art to be disclosed. This was thought to be an isolated incident, the EPO suggesting that we could call the Director in such circumstances.

Although attorneys can request an informal telecon with the Director, we must also decide if this constitutes a formal complaint, as there is a separate procedure for this. The EPO welcomed feedback on problems *epi* members encounter. We can ask for an informal telecon, or make a written complaint, depending on the situation.

The *epi* is concerned that members are now more likely to receive a Summons only after the response to the first examination report. The EPO said that this was not an official policy, but they do want to speed up the granting procedure. There is a general drive to reduce the number of communications during examination.

The primary Examiner should look at an applicant's Rule 116 submissions soon after they are filed. The Examiner should decide, two weeks before the hearing, if Oral Proceedings are to be cancelled or postponed. If we do not hear by then, then we are encouraged to phone the Examiner. Often the Examining Division will only meet a day before the Oral Proceedings; before this the Primary Examiner is generally in charge.

#### 6. *Divisionals*

Say, for example, the parent case contains three inventions (A, B & C). Invention A is then pursued in the parent, and a divisional filed to B&C. A later disunity objection to B & C is the *same* objection.

Examiners may not want to get into arguments over what is the „same objection“, and so may be flexible. The EPO did consider a proposal that gave the Examining Division discretion on whether a divisional can be filed, but this would have presented additional burden for Examining Divisions.

The EPO was asked to make it clear if a disunity objection is being raised, and certainly if it is a new one, so that attorneys can correctly calculate the two year deadline.

#### 7. *Auxiliary Requests (ARs)*

This procedure is under consideration, as the EPO wants to limit the number of requests. The *epi* said that if we know that further ARs will be allowed on the day, at the Oral Proceedings, then we may not file so many in advance.

#### 8. *Sequence Listings*

The EPO says that it needs the sequence listings quickly so that it can get on with the searching. There is thus little sympathy for small mistakes in the listings (e.g. for simple mis-spelling of a protein). There are eight to ten Formalities Officers employed to check the sequence listings. The *epi* says that applicants are being punished unnecessarily for small errors which do not inhibit the EPO's ability to conduct the search.

If we can show that a sequence listing was previously filed at WIPO, during the International phase, then we can protest and the fee should not be payable.

# Report of the European Patent Practice Committee (EPPC)

F. Leyder (BE)  
Chairman

This report covers the most important items from the first half of 2010.

## DG3: Boards and Enlarged Board of Appeal

### 1. G1/10 and G2/10 – New referrals to the Enlarged Board of Appeal:

G1/10 relates to corrections after grant, whereas G2/10 relates to disclaimers of a disclosed embodiment. The EPPC will discuss the referrals on the occasion of its next meeting (25-26.10.2010) and may prepare *amicus curiae* briefs if there is sufficient interest.

### 2. Decisions published:

Decisions G1/07 (Method of treatment by surgery), G4/08 (Language of the proceedings) and G2/08 (Dosage regime) have been published in February; opinion G3/08 (Programs for computers) has issued on 12.05.2010.

### 3. Next MBA

The yearly meeting used to be attended by members of SACEPO, hence its former name MSBA (*Meeting of SACEPO with the Boards of Appeal*). It has now been decided to uncouple the meeting from the SACEPO meeting, and it will thus be known as MBA. The date has now been set on Friday 12.11.2010. The delegation will comprise the President, Vice-Presidents, and seven members (five from the EPPC and two from the Biotech committee). *epi* members are welcome to suggest general subjects for discussion (no individual cases can be discussed).

## Liaison sub-committee

### 4. Partnership for Quality (PfQ)

Mr Philpott has been replaced *ad interim* by Mr Cordera, who has indicated that he intends to continue in the same way. A meeting took place in June, with *epi* and BusinessEurope.

## PCT & Trilateral sub-committee

### 5. WIPO enquiry

In response to a WIPO enquiry to PCT authorities, the EPPC drafted the letter sent by *epi*, supporting WIPO in its efforts to develop the PCT.

### 6. PCT Workgroup

*epi* was represented at the 3<sup>rd</sup> meeting, which took place from 14 to 18.06.2010. All meeting papers, including the report, are available on the WIPO website. Besides

the future of the PCT, the delegates mainly discussed third party observations (the International Bureau will undertake further consultations), the eligibility criteria for reductions in fees (no agreement), a procedure for correction of errors made by the Receiving Office (to be clarified by way of a modification to the Guidelines), photographs and colour drawings (no conclusion) and alphanumeric numbering of figures (actually already accepted)

## EPC sub-committee

### 7. Procedural efficiency (CA 162/09)

An *ad hoc* working group has met on 18.02.2010 to consider an EPO document on Procedural Efficiency (CA 162/09). The provisional conclusions were summarised in an internal working document. Before the last Council meeting (Strasbourg, 12.06.2010), a pre-meeting was organised during which this was discussed. The document was finally approved by Council and sent to the Administrative Council; it can be found on the **epi** website.

### 8. CPL38, SACEPO/WPR3 and CPL39

The main item to be discussed at the meeting of the 38<sup>th</sup> Committee on Patent Law (CPL 38) on 23-24.02.2010 was the amendment of R. 71. The working group that met on 18.02.2010 (see item 8 below) analysed the paper and came to the conclusion that it was wholly unacceptable. Some members of the group then took the initiative to informally convey this as a personal comment to the delegates of their country to the CPL meeting. After a long discussion, the conclusion of CPL 38 was that the EPO promised to amend the proposal and to consult the users.

The main defect of the first draft was that Examining Divisions were explicitly allowed to make amendments under R. 71(3), without having to explain what the reasons for the amendments might be; the draft also did not specify how the applicant should proceed in case he did not accept the proposed amendments. The EPO acknowledges that 15 % of the amendments proposed by Examining Divisions are not accepted by the applicants.

The EPO accordingly prepared a new draft for discussion with the users. The SACEPO/WPR3 meeting was cancelled twice because of the ash cloud. It was finally held on 01.07.2010. The new draft no longer had the above defects but considered as an amendment a request by the applicant to maintain his last request.

At the time of writing this report, the EPO had produced yet another draft for comments. The next CPL meeting (CPL 39) had been summoned for 27.09.2010.

#### 9. *R. 36(1)(a) and the communications from the Examining Divisions*

The wording of R. 36(1)(a) refers to „from the Examining Division's first communication“. It now appears that some communications under R. 161 and some reminders for renewal fees are signed on behalf of Examining Divisions, and it would appear that they could indeed trigger the 24-month period. The *Travaux Préparatoires* and the numerous Notices from the EPO pretend that only communications under Art. 94(3) or R. 71(3) can trigger the period; however it is not certain that these documents can be used to interpret R. 36(1)(a), which appears crystal clear on that specific point.

During the EPC2DAY training event, participants raised the point, and the EPO representatives kept to the then official position. Thereafter, CIPA has written to the President of the EPO, asking for more certainty.

This question was briefly discussed at SACEPO/WPR3. At the time of writing this report, the EPO had produced a draft for comments. It is hoped that legislative clarification can be made sooner rather than later.

#### 10. *R. 161(1) communications*

The EPO always pretended that the period of one month for responding to the written opinion of the International Searching Authority (or the International Preliminary Examination Report or the explanations given in accordance with Rule 45bis.7(e) PCT) was sufficient, on the basis that the applicant had had enough time.

The EPO has now realised that some applicants enter the European phase themselves, and seek the assistance of a professional representative only when they receive the communication under R. 161(1).

This question was briefly discussed at SACEPO/WPR3. At the time of writing this report, the EPO had produced a draft for comments.

#### 11. *Further amendments of the Implementing Regulations*

*epi* members are welcome to address to the EPPC their suggestions as to further amendments of the Implementing Regulations, preferably via the delegate(s) of their constituency.

In this regard, I have noted that some members have recently opted to write an article in German language in this journal. I would suggest that an abstract should be submitted for publication with the full paper. Ideally, the abstract would be in English.

### Community Patent sub-committee

#### 12. *The EU Patent*

Since the Lisbon Treaty entered into force on 01.12.2010, the European Community has been replaced by the European Union. The Community Patent will therefore be known as the EU Patent. The Community Patent sub-committee might be renamed to EU Patent sub-committee once we will all be familiar with the new name.

#### 13. *Update on the EU Patent*

An EPPC meeting has taken place on 18-19.05.2010. It took place in Brussels, and we had Messrs Stohr (EPO, DG5) and Várhelyi (European Commission, EC) as guests. My thanks go to those who contributed to the organisation, in particular the President and the Treasurer.

During the question time after Mr Várhelyi's presentation, it became clear that the EC had not realised how prior national rights would affect EU patents. He welcomed written submissions. A letter was thus prepared and sent by our President to the EC.

Commissioner Barnier should have announced a proposal for the Language Regulation on 18.05.2010; it finally issued on 01.07.2010 (no translation of the EU patent).

In the meantime, the European Parliament had confirmed its first reading of the draft EU Patent Regulation and sent it back to the EC.

### Guidelines sub-committee

#### 14. *Guidelines for examination at the EPO*

It is still unclear whether the EPO will live up to its promise to update the Guidelines every year. The sub-committee will meet on 06.09.2010 to update its list of proposed amendments. *epi* members are welcome to forward their suggestions at any time during the year.

### Miscellaneous

#### 15. *Fee Reform and Sustainable Financing of the European Patent System (CA 160/09)*

The Board has approved the sending to the President of the AC and of the EPO of so-called „*epi*’s first comments“ on paper CA160/09, without including the opinion of the EPPC.

During its last meeting, the EPPC informally considered those of the „first comments“ that relate to subject matter within its Terms of Reference.

A working group comprising EPPC members has now been set up to further comment on paper CA 160/09; the first meeting has been set to take place on 13.09.2010.

## Report of the Litigation Committee

E. Lyndon Stanford (GB)  
Chairman

### **The European and European Union Patents Court (EEUPC), draft Agreement**

1. The text of the draft Agreement is that of Working Document 7928/09 as amended by document 17229/09 („December 2009 Council Conclusions“). After a transitional period, the Agreement provides for a single court system for all EPC bundle patents and EU Patents. There will be first instance courts in all states or groups of states that want them and a central first instance court. In general, the local language will be used and in general there will be a technical judge on all panels. There will be a single court of appeal, in general using the language of the first instance case. Questions can be referred to the Court of Justice of the European Union (previously the ECJ). Representation can be by lawyers or by European Patent Attorneys with an appropriate higher qualification. Patent attorneys (not just EPA's) can assist in court and speak.

2. The text of the draft Agreement has been submitted to the Court of Justice for an opinion on the compatibility of the draft Agreement with the founding treaties. It is expected that the Court will hand down its opinion in October 2010. At the hearing, the European Commission seemed to accept that the EU Patent Regulation should be enacted before the Agreement is concluded. The impression is that the Court will not give a clear answer in favour of the draft Agreement and in any case amendments will be proposed following consideration of the Court opinion (assuming that the whole project is not abandoned). Eventually, as the Agreement is an international treaty, there will be a diplomatic conference to settle the terms. With the present drafting, the Agreement must be ratified by the EU, all the EU states and at least one non-EU EPC state.

3. At the June 2010 Council meeting, the *epi* approved the general principles of the draft Agreement.

4. There is a privilege issue which is being studied by the EPPC, namely the extent to which European Patent

Attorney representatives and patent attorney participants should have privilege.

### **Advocacy Paper**

5. It is intended that this paper be used as a basis for explaining to governments of the EU states why European Patent Attorneys should have powers of representation. The paper notes that as part of the proposal, European Patent Attorneys who have an appropriate qualification can represent in court, as well as lawyers, that the Court will be a technical court with new procedures, that European Patent Attorneys have technical qualifications, are highly experienced in patent matters, are regulated by a code of professional conduct, and will have training in the new procedures, and that the adoption of European Patent Attorneys as representatives will have significant cost benefits and provide effective litigation.

### **The draft EEUPC Rules of Procedure**

6. The European Commission has continued discussions of the details of the draft Rules with representatives of various interested bodies. The European Commission has indicated that further amendments will be made. The Litigation Committee is closely following developments.

### **Enforcement**

7. The European Commission has engaged the Centre for Strategy and Evaluation Services (CSES) to review Brussels I. In turn the CSES sought practitioners who could give their views of the operation of Brussels I, but the *epi* did not make any submissions.

### **Table of Representation**

8. On behalf of the Committee, Dr. Török is collaborating with CNIPA to maintain an up-to-date table indicating the representation rights of patent attorneys in every state of the EU.

# Report of the Online Communications Committee (OCC) Single Patent Process (SPP) Programme

R. Burt (GB)  
Chairman

## Introduction

The EPO launched the Single Patent Process (SPP) programme in April 2009 to redesign and improve the patent and business processes of the EPO. The programme is comprehensively defined and discussed in the Programme Definition Document (PDD) – current version being v2.1 (as of February 2010). The PDD is currently an internal EPO document. The best way to describe SPP is as a single integrated system into which patent applications are fed at one end and granted patents or refused applications come out the other end – in between, all the actions of the Examining Division, Formalities Section, representative, Opposition Division, Appeal Division seamlessly work together using an optimised IT system.

The cost of SPP is given as 240 million Euros over the period 2009 to 2016 with benefits of 130 million Euros per year in 2016 and beyond.

The SPP Programme started with a detailed analysis of all the current EPO processes and from the analysis defined a future working state for the organisation and all parties that interact with it. The key aim of SPP is stated to be a reduction in the administrative burden upon the constituent parts of the EPO.

One major feature of SPP will be an electronic dossier for every application and the eventual phasing out of the labour-intensive maintained paper files. A second major feature of SPP will be the „patent workbench“ which for all EPO employees will be the single user interface to all the tools, files, and other materials.

SPP will bring major changes to the way all EPO employees work and will necessarily change the way that the applicant interacts with the EPO. In order to obtain maximum benefit from the SPP programme the majority of communications between the examiner and the applicant should be in electronic form. One key element of SPP which will be important to applicants and their representatives is that the EPO is working on the basis that all filings at the office will be in electronic form from 2013 onwards.

## External Focus Group

The EPO appreciates that SPP will only be successful if the applicants and their representatives fully co-operate and work with the new processes. The EPO has set up an External Focus Group with a membership made up of professional representatives and formalities experts. The EPO has also appointed an external advisor, Mr Ruud Peters, CEO Philips Intellectual Property & Standards, to

the SPP Programme Board to ensure the interests of external users are properly reflected in the programme.

The EPO has held two meetings with the External Focus Group (EFG). The first meeting in November 2009 was primarily to establish the EFG and to give an introduction to SPP. The current membership of the EFG includes the members of the OCC, two additional members of the epi Council, four European patent attorneys not on epi Council or any epi committee, and three additional members with patent administration expertise, giving a total membership of 17 members. The chairman of the EFG is Antero Vikkala, an OCC member from Finland.

## EFG meeting 1

In addition to establishing the EFG, introducing its members and being given an introduction to SPP, the first meeting included discussions with the EPO representatives to understand the „external“ benefits of SPP. The aim was to establish what benefits there would be for the applicant and his representative from SPP in terms of application filing, communication with the EPO, payment of fees, searching, and administration, and to determine whether there were other benefits that could be realised by suitable changes within the framework of SPP that would lead to cost and effort savings for the applicant/representative. The outcome of the first meeting of the EFG from the members perspective was that there is a desire to see simplified procedures, reduced administrative work, simplified fee structures, more predictability for when the applicant will receive communications from the EPO, together with safeguards to ensure any transition to a fully electronic system does not place applicants or representatives at risk of losing valuable rights.

## EFG meeting 2

The second meeting opened with an update on current status of the SPP Programme followed by a presentation by Mr Ruud Peters giving an outline of the benefits he sees for his own company, Philips, once the programme is complete.

The main part of the meeting was taken up with breakout sessions in which there were moderated discussions in group covering two topics:

- 1) understanding external benefits of SPP, and
- 2) authenticating and security, including secure filing of applications, file inspection and related issues.



Topic 1 was aimed at giving the EPO an understanding of the applicants' and representatives' expectations as regards benefits resulting from the SPP programme. One important issue considered is the need to improve communication and collaboration between examiners and representatives including promoting mutual respect and co-operation between the two highly skilled and talented parties in the granting process. The SPP programme would allow greater use of „informal“ channels of communication such as e-mail whilst ensuring automated incorporation of material in the dossier for legal certainty.

The SPP proposal for a full electronic dossier was seen as the logical progression for file handling and could ease one of the inefficiencies in the system, namely the time it takes for communications to and from the examiner to be placed on the file. It might also enable more compact handling of the examination and remove the greatest inefficiency in the system, being the need to read back into the invention because of the long time between each task undertaken by examiner and representative.

The description in the SPP PDD of the enhanced searching facilities being proposed for examiners prompted requests from representatives for access to the same tools. It was believed that this would have a positive effect on the quality of drafted applications. Questions such as training in the use of the search tools and access conditions will need careful consideration and the EPO will consider whether access was feasible.

The inevitable question that arises when considering on-line filing and an electronic dossier is the desired

format for the text and drawings in the application documents. The use of an exchangeable version of the application with tracked changes allowing collaborative editing is a very attractive option; however, an agreed format has still to be decided (Word, XML?). Whatever format is mandated must be available and acceptable to all, including applicants representing themselves, and not require risky conversion steps. It was agreed that the use of pdf as the format was unsuitable because a readily editable format was required.

Topic 2 covered authentication and discussed issues such as the smart card system currently in use and viable alternatives. The current smart card system is seen to have some advantages but the cost of administering it is large, and the need to rapidly revoke access when attorneys move employer or applicants move attorneys needs to be addressed if more reliance is to be placed upon such a system.

The implementation of SPP and the integration with the IT systems of applicants and representatives means that solutions must be found to ensure secure communication. It is currently the case that some applicants and attorneys are unable to use the electronic filing system because their company policies do not permit installation of external software or do not permit the lowering of firewall protection sufficiently to allow exchange of data with the EPO systems; it would be unacceptable for the EPO to introduce a system that was inaccessible to some applicants and representatives.

The SPP EFG will convene again in November 2010 for an update on the progress of SPP.

## Report of the Professional Qualification Committee (PQC)

F. Schweinzer (AT)  
Chairman

PQC had a regular meeting on March 22, 2010 in Munich where 30 countries (out of maximum 32) were represented.

### 1. EQE 2010

At first glance there seems to be no major impact of the new REE/IPREE on registration. There were only a few candidates using the new possibility of taking any paper in a desired sequence. However it was seen that in 2010 the number of first sitters was reduced dramatically for which no reason could be found. The results are expected in August.

### 2. REE and IPREE

The new REE came into force on January 1<sup>st</sup> 2009 and the new IPREE on April 1<sup>st</sup> 2009. In the revised IPREE, which came into force on April 1<sup>st</sup> 2010 the content of the pre examination which will be held in 2012 for the first time is now defined. It will consist of legal questions and questions on at least one technical proposal from a client, at least one draft claim in respect of that technical proposal and at least one relevant prior art document. Candidates will be expected to answer questions on the allowability of the claim(s) under the EPC and as to whether the claim(s) provide(s) the broadest possible protection under the EPC. The pre-examination will last 4



hours. To compensate for this additional paper the other papers will be reduced in content and duration.

There has been a test pre-examination which may be found on the EQE website of the EPO. The new IPREE is published as supplement 2 to the OJ March 2010.

### 3. MoU (Joint activities CEIPI – epi – EPO)

Now the Study Guide for EQE candidates has been published. A second edition is under preparation. An e-learning module for special questions of paper D1 is accessible on the EPO website. Paper A questions will be available soon.

Further a mentor's meeting has taken place on November 22-23, 2009 in Berlin to also „teach“ the mentors and supervisors of candidates and exchange their experiences. Follow up seminars are considered.

### 4. CPE

In the Council at Düsseldorf on October 10, 2009 a mandatory system of CPE for *epi* members to ensure a high quality of advising our clients/companies has been voted against. PQC is now studying the CPE regulations for various professions in European countries.

A main project on CPE seminars in 2009 was the train the trainers course with 23 participants from 8 (new) countries. It was held in three modules of a week each. Now the first follow up seminars in these countries are held to distribute the knowledge among the profession in these countries. Already a few follow up seminars in various countries took place and others are planned for the near future. It seems that this type of seminar was

very successful, especially to spread the knowledge to our members.

Our existing seminars and also new topics as „The new developments in PCT“ are also held at various locations, latest in Lisbon on January 15, 2010. Seminars on „EPC 2000 in practice“ (the final title may be different) are planned to take place at various locations in Europe over the year.

If there is an interest in any *epi* seminar (possible topics may be obtained from the secretariat or our Director of Education) please contact the secretariat.

### 5. Tutorials

A new type of tutorials was established starting 2008 as Mock EQE with a test EQE under examination conditions and a meeting with tutors in a second session to discuss the written papers of the candidates individually. The result of the Mock EQEs in Helsinki and Munich is now evaluated and it is intended to hold these Mock EQEs also in other cities/countries in autumn.

### 6. Director of Education

Our Director of Education is organising the main activities (seminars, Tutorials) with the help of the secretariat. Further he is working closely with the European Patent Academy in the MoU working groups and projects. On March 26 Henk Hanneman resigned from the position as Director of Education. The presidium has nominated Selda Arkan and Claude Quintelier as Director of Education ad interim. Now we establish a contract with job description and will look for a Director of Education in autumn this year.

## Report on the 42<sup>nd</sup> SACEPO Meeting 21<sup>st</sup> June 2010

W. Holzer (AT)

The main Agenda items discussed during the 41<sup>st</sup> SACEPO meeting were the following: President's Report and an Address by David Kappos, the Under Secretary of Commerce for Intellectual Property and Director of the USPTO; IP5 activities; Utilisation implementation project; PCT matters; EU patent – status report; Patents in the context of climate change negotiations and the joint UNEP-EPO-ICTSD report; International co-operation; Rule changes.

In her last SACEPO Meeting as President of the EPO, Alison Brimelow first of all introduced David Kappos, who participated in part of the meeting and took the floor to present a report about his Office. Ms. Brimelow in her report on the development of the European patent system evoked the general success of the IP system, which however at the same time is responsible for its current problems, mainly how to deal with new technologies and the backlogs of the Offices. IP has moved into the spotlight over the past 20 years and has become

an issue in policy debates. The system which is under public scrutiny could drift in unwanted directions. The current economic crisis regrettably coincides with the international understanding of Patent Offices to jointly improve the global IP infrastructure. As a result of the economic crises, fewer applications are being filed.

The EPO has grown to 37 member states (including Albania). Serbia will join in 2010. The extension system will include Montenegro and Morocco (also in the form of a validation agreement). Since 2003 considerable progress has been made in the design of EPO procedures, although the 30 year old IT system needs to be reformed. More effort is exerted earlier in the procedure. Timeliness has improved and written opinions now always come with the search report. The EPO reports a reduced backlog in search and is now concentrating on reducing the examination backlog.

The project „Raising the Bar“ is improving quality. The grant rate, however, is down (due to the new quality standards?). The current fee design is counterproductive: 16 % of the patents live up to 16 years and create 15 % of the Office's income; 24 % live for less than 15 years and create 31 % of the income; the rest is neutral. High quality has its price, in that the successful applicants pay for the non-successful.

Work sharing in the context of the utilisation project (UPP) must be enhanced. The EPN Network and the IP5 project, to be dealt with later in this report, will start from 1<sup>st</sup> January 2011. Article 124 and Rule 141 EPC will come into force. The Office at the end must arrive at a position of sustainable financing. The well being of the PCT is a key element.

The USPTO Director, David Kappos, considers innovation as the key to recovery of the economy. The problem is that the change is global, the impact, however, localised. The Patent Offices have to play a leading role in the innovation cycle; however, they have not done a good enough job in that respect. A problem is their backlog, the situation needs to change quickly. The present status of the USPTO shows a backlog of 736.000. Filing has decreased by 2 %. In order to reduce pendency time (currently at 27 months) and increase efficiency, a number of initiatives were taken. A new examiner product credit or count system is being installed as well as a new productivity bonus structure and a „First Action Interview Program“. A 3-track prosecution system is envisaged: with a first filing at the USPTO the applicant can request accelerated examination or wait for regular examination or the applicant can delay examination for up to 30 months. A new examiners' hiring system is being implemented. Experienced persons, such as patent attorneys and former examiners are hired. However, David Kappos says: At the end of the day, hiring, IT and process improvements are not going to provide the answers to all of the Office's workload problems. Offices must find ways to work smarter together, to succeed in work-sharing and to facilitate acceptance of work done in another office. Therefore, co-operation in the IP5 Offices (EPO, USPTO, JPO, SIPO and KIPO) should be accelerated.

The EPO reported on progress in IP5 activities ([www.fiveipoffices.org](http://www.fiveipoffices.org)) as to a greater integration of the global patent system work-sharing. The most important progress takes place in „IT-related Business Processes“, such as common application format, mutual machine translation, common access tools, common documentation, common search and examination support tools, sharing and documenting search strategies, as well as common search and examination rules and quality management. In this respect also a common training policy, such as cross training between the 5 Offices is taking place, with an IP5 e-learning platform, and an examiners' workshop. A revised classification makes it easier to search for patent information regarding environmentally sound technologies on the [esp@cenet](mailto:esp@cenet).

The EPO International Co-operation Activities were presented. A large portion of these activities are funded by the EC. The objectives are to secure the proper functioning of the EPO. The interdependency of Patent Offices has increased, in particular as concerns access to prior art, quality of the incoming applications and work sharing initiatives. Another objective is the support of the EU and EPO member states global policy, in particular EC funded IP co-operation projects. Furthermore, the development of the global patent system should be influenced, as regards quality and legal certainty of patents granted in third countries, to promote harmonisation processes, and a more efficient use of the IP system. The priority countries are countries with high R&D expenses and high numbers of national applications. The guiding principles are partnership agreements, accountability and co-financing coordination.

Regional IP Offices, such as the Eurasian, African, ASEAN are being supported, in particular as regards the implementation of three EC funded projects: IPR enforcement in China (IPR2), harmonising and upgrading IP systems in the ASEAN region (ECAPIII), approximating EU and Russian Federation IPR aspects.

The EPO is increasing its access to prior art. China provides a collection of Chinese bibliographic data complete from 1985 to present; India supplies a Traditional Knowledge Digital Library; the legal status of Russian patents is available on INPADOC; in Latin America a LATIPAT- [esp@cenet](mailto:esp@cenet) website has been installed. Work is shared with the Chinese Office on classification, exchange of priority documents and quality management.

The most important aspect in PCT matters appears to be the Collaborative International Search and Preliminary Examination pre-pilot project with the USPTO and the KIPO initially involved. The ISA remains the primary and responsible ISA. Results will become available in the third quarter of 2010.

Utilisation activities at the EPO (UPP) have shown that work carried out by the Office of First Filing (OFF) during the priority year can be utilised by the EPO. Amended Rule 141 EPC and new Rule 70b EPC will enter into force on January 1, 2011, and will apply to European patent applications and international applications filed on or after that date. Simply to recall the contents of Rule 141:

an applicant claiming priority has to file a copy of the search result of any novelty search carried out by an OFF. New Rule 70b EPC provides for an invitation by the EPO to file within a non-extendable period of two months copies of relevant search results or a statement of the non-availability of these search results. Failure to reply has the consequence that the European application is deemed to be withdrawn. If the OFF search results are already available to the EPO applicants may be exempted from the obligation of filing a copy.

As concerns the PPH (Patent Prosecution Highway), it is envisaged that claims found allowable/patentable by an OFF may cause an advance of application in OSF. European participation in PPH projects is moderate, however. Future comprehensive utilisation schemes will ultimately apply to all applications processed by the EPO in line with the IP5 process, with the overhaul of IT infrastructure, and the integration of work-sharing activities, in particular PPH.

In the general debate, an *epi* member asked whether measuring the quality in the context of raising the bar has been measured correctly. He pointed out that in 2009 52000 patents were granted (which was a deficit of 13 % over the previous year) and whether this translates into quality?

On the other hand, in the first quarter of 2010 grants have increased by 18 %. Does that mean that quality has

improved or decreased? Ms. Brimelow answered that this was a philosophical question. At any rate there has been an increase of withdrawals due to 1<sup>st</sup> examination reports. On the other hand, pendency times remained at 43 months and the number of unexamined cases has increased to about 500.000. The rate of oppositions decreased, whereas the rate of appeals increased.

Rule Changes, in particular Rule 161, were brought up by the *epi*.

Unintended consequences would result from revised Rules 36 and 161. There seems to be an implementation problem. Rule 161 causes confusion, also due to the various notices that are being published to clarify the Rule. The Office agreed that the consultation should be improved.

Another point raised by the *epi* concerned the Guidelines for Examination. The Office noted that the Internal Instructions for Examiners would be incorporated in the next Guidelines. This however is a huge task as the contents of about 600 plus 400 pages need to be combined.

All in all, the SACEPO meeting provided a lot of information, however less topics for advice by SACEPO members, a situation that should be remedied in the next meeting.

## Staff Situation in the Secretariat

P.G. Maué (CH)  
Secretary General

During the process of getting acquainted with and analysing the processes in the Secretariat following the employment of Ms Ortlepp as Office Manager, we became aware of substantial irregularities in the accounting area. Over the period of the last ten years and despite the regular control exercised by the Treasurer, the internal auditors and the external auditing firm, these irregularities reached an amount of close to 500'000 EUR. This led immediately to the termination of the working contracts of the internal bookkeepers. Furthermore, court proceedings were initiated regarding

the labour aspect of the assumed wrong doings and, in addition, a criminal investigation is being carried out following my complaint in the name of *epi*. A judgment regarding the labour aspect, including the claim for restitution of the above mentioned amount, may be expected before the end of this year whereas the criminal investigations will take longer. For the time being, the accounting tasks are carried out by the permanent staff of the Secretariat with the help of temporary external staff but it is expected that by the beginning of October the accounting position of the Secretariat will be fully staffed.

## epi Excess Liability Insurance 2009/2010

On 1 October 2010 the *epi* Excess Liability Insurance scheme will be renewed for a further year. It aims to give better insurance coverage at a reasonable price to *epi* members.

The indemnity of basic professional liability insurance schemes is often limited to EUR 1.022.584. Therefore, the *epi* Excess Liability Insurance scheme indemnifies losses as far as they exceed EUR 1.022.584/equivalent. Its limit of indemnity is a further EUR 1.533.876 per loss so that – together with basic insurance – a total loss of EUR 2.556.400 is covered.

There is a collective indemnity limit to EUR 15.338.756 p.a. for all participating *epi* members which according to insurance calculations will hardly be reached. The premium for the *epi* Excess Liability Insurance scheme for the insurance year 2010/2011 amounts to **EUR 402,64** plus legal insurance tax per joining *epi* member.

Persons wishing to join the *epi* insurance policy should directly contact the broker, Funk GmbH, for all policy matters, application forms etc., and payments. Please make your payments to the broker's account mentioned hereafter, free of bank charges, indicating the following reference „*epi* insurance 01 0047425000“ (this is the *epi* client number with the broker) as well as your name.

*epi* invites each member to carefully consider joining the *epi* Excess Liability Insurance scheme since clients' claims may easily reach the sum of EUR 2.556.460. They may ruin your economic and professional situation if no adequate insurance cover is provided for. The *epi* Excess Liability Insurance scheme improves your insurance cover at a reasonable price and provides insurance cover for you as an *epi* member in all thirty-eight EPC contractual countries regardless of where you exercise your profession.

For further information on the *epi* Excess Liability Insurance please contact:

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## Next Board and Council Meetings

### *Board Meetings*

84<sup>th</sup> Board meeting on 19 March 2011 in Budapest (HU)

### *Council Meetings*

69<sup>th</sup> Council meeting on 20 November 2010 in Berlin (DE)

70<sup>th</sup> Council meeting on 23-24 May 2011 in Dublin (IE)

## Next Tutorials and Training seminars

- Mock EQE in Helsinki (FI)  
2–4.11.2010 – Mock EQE  
1.–3.12.2010 – Tutoring session

- EPC2DAY – Impact of the changes by EPC2000

### Next seminars:

- 08.10.2010 Munich (for paralegals and administrative staff)
- 15.11.2010 Milan
- 26.11.2010 Eindhoven

For further information, please visit our website [www.patentepi.com](http://www.patentepi.com)

## Update of the European Patent Attorneys database

For the attention of all *epi* members

Kindly note the following contact data of the Legal Division of the EPO:

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Legal Division  
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legaldivision@epo.org

Please send any change of contact details to the European Patent Office so that the list of professional representatives can be kept up to date. Be aware that the list of professional representatives, kept by the EPO, is the list used by the *epi*. Therefore, to make sure that *epi* mailings as well as e-mail correspondence reach you at the correct address, please inform the EPO Directorate 5.2.4 of any change in your contact details.

Thank you for your cooperation.

## AIPLA/FICPI Colloquium on Patent Offices' Backlog Crisis Edinburgh 17–18 June 2010

This was a timely and high-powered meeting, with senior representatives participating from the major Patent Offices, WIPO and Users including GE, Microsoft, Eli Lilly, and Unilever, as well as practising patent attorneys, including our President, who spoke in a session relating to fee strategies to influence User behaviour. He made the point, well received by the audience, that when trying to lasso an animal too tight a pull on the rope can be fatal.

The view of the meeting was that duplication of work in Patent Offices is a major cause of the backlog. It seems that about 130 000 of 250 000 applications are duplicated in Patent Offices around the world. The meeting agreed that the corollary to this is that work-sharing is required but that quality of granted patents should not be prejudiced.

Arti Rai, Administrator for Office of External Affairs at the USPTO gave a comprehensive over-view of action being taken at the USPTO to improve matters. She mentioned a pilot scheme between the USPTO, JPO and EPO covering 100 applications per work module to try to avoid duplication. This is known as „First Look Application Sharing“, FLASH. The aim of this project is to



Alan Kasper, President of AIPLA

dispose of an application in about 18 months. Robert Stoll, Commissioner for Patents at the USPTO also gave a presentation reporting that in the US there are 1.2 million applications in process with 730 000 effectively comprising the back-log. He informed the meeting, inter alia, that overtime was paid to USPTO examiners and that an Ombudsman programme has been set up, there being an „ombudsmen“ in every practise group to deal with user complaints. Moreover, USPTO PCT cases were outsourced, examiners being encouraged to use whatever sources they can from the ISA.

There was a question as to how quality can be checked, interesting answers being given on behalf of users, eg Unilever it seems test their applications against a search they carry out before an application is filed. We were told that Microsoft manage their applications in the US via external attorneys who are usually individual attorneys scattered around the US who have to work strictly to criteria laid down by Microsoft. Further, Eli Lilly use attorney peer review of a specification before it is filed.

It was also observed in discussion that the user community are willing to pay official fees even if those are



Peter Huntsman, International President of FICPI



increased, but only if they have confidence that such fees are ring-fenced for the good of the IP system. The interesting observation was made too, that back-logs are not new; they have been around for some time. So why the urgency now? The answer seems to be that all Patent Offices are experiencing an increase in applications and steps such as work-sharing have to be taken, and taken globally, in order to avoid the system grinding to a halt, which would not be to the benefit of society. In short, the general consensus from the Colloquium was that the backlog is here, it is acknowledged that it cannot be allowed to continue or grow, and that steps have to be taken to reduce it for the general good of the IP system and society.

In view of the luminaries present, the opportunity was taken on behalf of our institute to interview some of them.

Arti Rai was asked what she would say was the greatest driver to solving the backlog problem worldwide. She replied that as far as the US was concerned it was „providing sufficient funds to increase examiner firepower which will include insuring that a viable IT system is in place“.

The respective Presidents of AIPLA and FICPI were thanked for their initiative in organising the Colloquium and asked how they see their respective organisations' relationship with the *epi*. Alan Kasper (President of AIPLA) said „AIPLA is delighted with *epi*'s involvement

in the Colloquium, and will also look forward to *epi*'s participation in the next Global IP Practitioners' Associations' summit in October“.

Peter Huntsman (International President of FICPI), said „FICPI looks forward to continuing its cooperation with the *epi*, particularly in the field of education as both FICPI and the *epi* believe in the essential requirement for a quality qualified patent attorney profession in each territory for the good of all users of the IP system world-wide“.

Following the Colloquium there was an additional seminar on the Patent Prosecution Highway (PPH). Participants learned that Undersecretary Kappos at the USPTO has been tasked with increasing involvement of the US with PPH. We also learned that the JPO is, not surprisingly, the largest user of PPH. The USPTO cooperates with the JPO on about 3000 applications per year and wants to double this year on year. It was emphasised too, that the PCT essentially provides core work sharing, and that in the US the PCT is being adopted as part of PPH via a pilot scheme initiated in January of this year. The national Patent Offices should, we were told, accord respect to the PCT and its International Phase Reports as this would lead to work-sharing and should therefore reduce strain in the IP system globally.

TL Johnson  
Editorial Committee  
Reporter

## Translation of European Union Patents (EuP)

T. Johnson (GB)

Members will be aware of the ongoing negotiations concerning setting up a European Union patent (EuP).

One of the issues needing resolution is that of translation. The Member States have agreed that there would be a separate Regulation dealing with translation of the EuP. The Commission has proposed a draft Resolution in which the text of the proceedings leading to grant of the EuP is the authentic text, the claims only being translated into each of the other two official languages (of the EPO, which will be the examining and granting authority for the EuP).

For those interested in reading further, the Commission has published a Council Regulation on the translation arrangements for the European Union patent in documents COM(2010) 350 final, and SEC (2010)796. A summary of an impact assessment of this translation proposal can be found in document SEC (2010)97, Brussels, 30.06.2010.

Finally, the following link can provide additional information: [http://ec.europa.eu/internal\\_market/ind-prop/patent/index\\_en.htm](http://ec.europa.eu/internal_market/ind-prop/patent/index_en.htm)



# EPO's inescapable NDA-Standards Trap

A. Stellbrink<sup>1</sup> (DE)

## Abstract

The European Patent Office (EPO) renders many patent applications making use of terms being the subject of technology standards with underlying non-disclosure agreements (NDAs) as lacking sufficient disclosure. This applies to terms of a number of technologies, such as DVDs, Blue-Ray Discs etc.

The present discussion intends to draw attention to this practice often resulting in fatal rejections, would like to raise concerns about this practise and to initiate a public discussion.

## 1. Status at present

Certain technologies underlie standards or license contracts which require obtaining a license and under-signing a non-disclosure agreement to interested parties before providing the respective technology information. This concerns a broad range of various technologies with optical storage media such as DVDs, Blue-Ray Discs, CDs, speech, audio and video codices and compression techniques such as Dolby®, MP3, MPEG and broadcasting standards, as well-known examples. There are, however, many more such technologies owned by standard organizations, pools, holding companies or in very few cases even individuals. They concern wireless technologies, digital TV, home entertainment, video streaming, RFIDs, IT-related, semiconductor manufacturing, telecommunication, life science, nanotechnology, chemical and other technologies.

In the following the DVD standard DVD FLCC<sup>2</sup> being quite voluminous and contained in five books is chosen as an example. This standard underlies an NDA. Thus, even if an applicant referring to a DVD in a European patent application is aware of the standard's details, he cannot disclose all or some of the details in a patent application in view of an NDA being part of a license to this standard. On the other hand, in a large number of cases particularly being directed to DVDs and also Blue-Ray Discs, the EPO presently considers a mere reference to these or other respective standards or even just the use of the terms 'DVD' or 'Blue-Ray Disc' in claims to automatically prevent the invention from being sufficiently disclosed under Art. 83 European Patent Convention (EPC). This appears to be a serious problem preventing a substantial number of patent applications from being granted in the above mentioned fields or even applicable to these fields.

## 2. EPO's present approach

2.1 The EPO examiners generally refer to Art. 83 EPC, which reads that any European patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art.

In this context it is also held in a number of ongoing examination proceedings that the skilled person may use his common general knowledge to supplement the information contained in the application but such knowledge is only considered common and general if it is made available to the public or if there is no bar of confidentiality restricting use or dissemination of available information<sup>3</sup>.

2.2 Moreover, it is argued that any European search report shall be transmitted to the applicant together with copies of any cited documents<sup>4</sup>. Consequently, in view of the lack of public availability, any standard with an underlying NDA cannot be transmitted with the search report.

Finally, it is concluded that on the basis of such a situation any Examining Division can only grant a patent if the conditions laid down in the Implementing Regulations are fulfilled and that any application not fulfilling these conditions shall be refused unless the EPC provides for a different legal consequence<sup>5</sup>.

2.3 In a number of present cases, particularly in the field of DVDs and Blue-Ray Discs, reference is made to decision T 82/07<sup>6</sup> of the Technical Boards of Appeal (hereinafter referred to as Board of Appeal) which was directed to the insufficiency of disclosure of a method of converting a video and/or audio signal. In the patent application in question, the terms „DVD compatible program stream“ and „DVD compatible format“ were recited in the main claim without being further defined in the specification. In the appeal proceedings of that case, the appellant and applicant referred to the above mentioned DVD books defining the respective standard and their availability to the public, which was finally disregarded by the Board of Appeal. During prosecution this decision is taken as a basis for the conclusion that any application referring to a DVD is not considered to provide sufficient disclosure. In a number of examination proceedings the EPO examiners further refer to a passage in this decision which emphasizes that the con-

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2 DVD Format/Logo Licensing Corporation

3 See presentation of Mr. Martin van Staveren, held on April 29, 2009 at the European Patent Forum and Patinova on March 28-30, 2009 in Prague, Czech Republic with reference to the Guidelines for Examination, C-IV, 6.1

4 Rule 65 EPC

5 See presentation of Mr. Martin van Staveren, previously-cited

6 See T 82/07 of January 23, 2008

clusions of another decision, T 50/02<sup>7</sup>, of a Board of Appeal is not applicable, this decision concluding that a document belongs to the prior art even if it has to be purchased and is not freely available to the person skilled in the art.

These assessments and further associated aspects are discussed in more detail in the following.

### 3. Factual and legal considerations and consequences

3.1 It is stated that anything confidential cannot be considered to belong to the general knowledge of the person skilled in the art. However, the passage of the Guidelines generally referred to in that respect is directed to the term 'state of the art' being contained in Art. 54 and 56 EPC but not in Art. 83. The latter provision just reads that a patent application shall disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art. Hence, no use of the term 'prior art' is found in the regulation concerning sufficient disclosure.

On the other hand, according to the Guidelines for Examination<sup>8</sup> the 'person skilled in the art' should be presumed to be a *skilled practitioner in the relevant field, who is possessed of average knowledge and ability and is aware of what was common general knowledge in the art at the relevant date*. He should also be presumed to have had access to everything in the 'state of the art'. The standard for the skilled person's knowledge is thus generally the same for the requirements of inventive step and sufficient disclosure<sup>9</sup>. The access to the prior art is just another source of knowledge, next to the average and common general knowledge of the person skilled in the art.

In Art. 83 EPC, the skilled person's ability to carry out the invention is mentioned, besides the disclosure in the application itself. There are basically two scenarios which will be considered by means of the DVD example. Firstly, the person skilled in the art of DVDs already had access to the standard(s) at issue in the past. Then, it can be concluded that the standard is accessible and known to him and is part of his knowledge.

Secondly, he did not have access to the standard before and, therefore, does not know it. According to the principles of standards and principles of European competition laws<sup>10</sup>, anybody who would like to carry out the subject of the standard, in this case the manufacturing of a DVD, will get access to it, e.g., under the provisos of getting a license on reasonable (FRAND<sup>11</sup>) conditions, and signing an NDA.

Summing up, the term 'state of the art' is not a subject of Art. 83 EPC and the person skilled in the art usually already had or can get access to a standard. This consequently results in the achievement of the requirement

of the wording of Art. 83 EPC, in that an invention falling under a certain standard can in fact be carried out by a person skilled in the art.

3.2 As previously mentioned in section 2.2, the EPO examiners refer to Rule 65 EPC being directed to search reports. However, Rule 61 EPC outlining the content of a European search report clarifies that documents shall be mentioned which may be relevant to novelty and inventive step. The relevance for the sufficiency of disclosure is not mentioned. Thus, regardless of its quality, a standard which is kept confidential by its holder and any user is not prior art and, therefore, is not to be cited in a search report. Rules 61 and 65 EPC do not appear relevant in this respect.

It can be counter-argued that such standards may indeed become relevant to the evaluation of novelty and inventive step. In this context it is referred to the fact that opposition proceedings are intended to give third parties a chance to attack patents just being granted and to particularly provide evidence for the presence of other relevant prior art which is generally not accessible to the EPO. The most prominent example is a public prior use.

Also the products of the standard, in the present example DVDs, have been available on the market for a long time. In case it contains any technical information being, on the one hand, available to the public under the general standards of the EPO and, on the other hand, relevant for an invention being subject of a later patent application, the respective information forms prior art and can be cited by any third party in opposition proceedings, as it is usually done under comparable scenarios concerning a public prior use. This is one purpose of opposition proceedings, as already outlined before.

Even if the standard itself is considered prior art, any third party knowing about it or having access to it can rely on it as general knowledge being accessible to a person skilled in the art when wanting to realize the invention. This does not mean that the entire standard has to be filed. Instead, only portions thereof being relevant can be filed after having contacted the holder of the standard beforehand in order to obtain permission, and/or by procuring other evidence provided for in the EPC<sup>12</sup> such as sworn statements or expert opinions not providing each and every detail of the standard, requests for information from the standard holder, offering witnesses, inspection, opinions, etc.

3.3 The decision<sup>13</sup> which is often relied upon by the EPO examiners is not appreciated as a whole. In this decision it was found that the subject-matter claimed – the DVD compatibility according to any DVD specification – was not sufficiently disclosed over the whole range claimed. Only in one embodiment of the specification the conversion of an MPEG-2 transporting stream into a DVD-video compatible program stream was discussed in detail. This was not considered to provide sufficient

7 See T 50/02 of June 29, 2004

8 See Guidelines for Examination in the European Patent Office, Part C-IV, 11.3

9 See also Case Law of the Boards of Appeal, 5th edition 2006, II.A.2 (a)

10 Arts. 81(3) and 82 EC

11 FRAND = Fair, Reasonable and Non Discriminatory terms

12 See Art. 117 EPC

13 T 82/07

disclosure over the entire range claimed also including, e.g., a DVD ROM<sup>14</sup>. It was even emphasised that the accessibility of the DVD books defining the respective standard was not relevant for the findings of the Board<sup>15</sup>. The Board just missed the specific features of the claimed invention attaining a general DVD compatibility. Moreover, the Board missed proof for the fact that the different specifications correspond in fact to different sections of one specification, namely the DVD books defining the standard.

As an aside, the latter proof could have been provided by an affidavit, for example, not disclosing confidential details but summarizing the general technical content of the standard.

Moreover, the Board asserted that the decision T 50/02 was not relevant as it was directed to the availability of a prior art document and that the application under dispute had omitted to provide any reference to such document, here the DVD books defining the standard.

As is generally known, the knowledge of the person skilled in the art and a reference to a document are both sufficient to provide an enabling disclosure. While it is believed that the existence of and access to a well-known standard by a skilled person alone can be considered to belong to the knowledge of the person skilled in the art, an explicit reference in a specification to the standard can further support sufficiency of disclosure. In the latter case, decision T 50/02 becomes relevant basically indicating that a document is considered to be made available to the public if all interested parties have an opportunity of gaining knowledge of the content of the document for their own purposes, even if they do not have a right to disseminate it to third parties, provided these third parties would be able to obtain that knowledge themselves by purchasing the document. As any manufacturer of a DVD, that is the person who would like to carry out the invention, can have access to the respective standard, even the requirements set out in T 50/02 are fulfilled.

#### 4. Associated aspects

4.1 The present practice of the EPO results in an inescapable trap: an applicant of a European patent application either has to breach the NDA underlying the standard, in our example case the DVD standard, or will not obtain a European patent in view of the lack of enabling disclosure.

4.2 This resulting trap goes even further: in case an invention claims a broad range, such as 'a storage medium' or a 'digital and/or optical storage medium', it unavoidably gets caught in the same inescapable trap!

As previously mentioned, the entire claimed range has to be enablingly or sufficiently disclosed in the corresponding specification. The broad wording of 'a storage

medium' exemplified before also embraces a DVD, which is generally not considered to be sufficiently disclosed. This would then consequently result in the lack of enabling disclosure over the entire claim scope. In case the application does not contain any direct and unambiguous disclosure allowing an exclusion of DVDs and other such standardized storage media or devices from the claimed range without inadmissibly broadening the application over the originally filed version, it again falls into the inescapable trap. As is known, the approach to be able to exclude a certain specific embodiment, such as a DVD, from a broad claimed range is extremely strict under the EPO practice<sup>16</sup>.

4.3 The standards such as the one mentioned often contain a huge amount of information. It would just inevitably corrupt the framework of a patent specification in case applicants would be forced to implement such complex standards.

4.4 Moreover, the lifetime of standards depends on the running time of the respective NDAs, irrespective of the standard's innovative quality. Such lifetime can be considerable, such as 10 years or even longer. Moreover such standards can most likely not coincidentally be developed a second time by another party without any criminal offence, due to their level of detailed information. Thus, such standards are different from an invention which would be patentable but which is kept confidential with the risk that the invention is developed a second time. This balanced situation between advantages and disadvantages of filing patent applications therefore does not apply to standards in the same manner as to secret inventions.

4.5 As already stated, standards are not or not exclusively the subject of patent protection. Otherwise their contents would have been disclosed and the problem discussed before could not arise. Standards may even not contain any above-average progress at all. Nevertheless, standards requiring an NDA are able to block any further developments from patent protection.

The well-known rewarding idea behind the patent system is to provide to the inventor, on the one hand, a kind of a monopoly right limited in time and to force the inventor, on the other hand, to disclose his invention. Thus, in the majority of cases, a patented invention is further developed not only after but also during the lifetime of the patent. The development of improvements during the lifetime of such patent result in independent or dependent patents. This scenario further leads to the general practice of cross-licenses in the industry making the originating invention of the patent accessible to a large number of parties.

This is not possible with standards being kept under an NDA and with the EPO continuing their present practice of refusing any patent application relating to such stan-

<sup>14</sup> See T 82/07, Reasons, sections 3.1 to 4.3

<sup>15</sup> See T 82/07, Reasons, sections 6.2 to 6.4

<sup>16</sup> Art. 123(2) EPC and the respective case law, e.g. see Case Law of the Boards of Appeal, 5th edition 2006, III.A. and B.

dards. Instead, the holders or contributing parties of a standard have a long-lasting exclusive basis for the entire technology hindering other parties to take notice and to improve the subject of such standards and get protection for such improvement. This appears to make such approach much more attractive even for trivial but perhaps complex standards than the patenting of highly inventive ideas.

Also for this reason, standards should not be allowed to constitute any considerable hindrances for the development of the relevant technical field during their lifetime. This would partly undermine the gist of the patent system by passively rewarding a standard with an NDA more than a patent application, irrespective of its innovative quality.

4.6 Furthermore, the legislation and the EPO practice do not appear entirely consistent. One example is the deposition of biological material<sup>17</sup>. In view of their complexity and the inability to describe biological material in a patent specification sufficiently, it is allowed to deposit them. In case a party would like to take a sample, a considerable fee and considerable efforts become due. In order to avoid any misuse of the material it is even possible to just allow an independent expert to take a sample and evaluate it without giving access to the biological material to the public before patenting or for twenty years from the date of filing, if the application is refused or withdrawn or deemed to be withdrawn. This is the so-called expert solution<sup>18</sup>.

Also, standards are generally very complex and not able to be implemented or even summarized in patent specifications. If they further underlie NDAs, an indepen-

dent expert could testify the sufficient disclosure of a patent application in view of the further information contained in the standards. Thus, in analogy to the latter example of depositing biological material, it appears at least fair to consider the standards to belong to the knowledge of the person skilled in the art and even further to make it sufficient for applicants to just refer to such standards in patent applications and thereby ensure a sufficient disclosure.

## 5. Conclusions

The present practice of examiners of the EPO to deny sufficient disclosure in case a term is used which is defined in a standard with an underlying NDA appears to be problematic and may be even getting much more problematic if consequently applied.

Many reasons have been discussed above to show that such standards can be considered to belong to the knowledge of the person skilled in the art, despite their confidential nature.

Under the present practice, it is further recommended to explicitly refer to relevant standards in case a patent application makes use of terms being specified or defined therein. In some cases, a number of standards may have to be mentioned.

For further safety reasons, patent applications should contain wording to allow the protection to extend to fields excluding fields underlying such NDA standards. This can best be realized by listing terms, fields etc. not underlying such NDA standards.

## Pitfalls created by raising the bar

D. Pust (DE)

Amended Rule 36 EPC concerning time limits for filing divisional applications and EPO communications under Rule 161(1) and Rule 162 EPC are among those legal changes which entered into force on April 1, 2010 and are intended for realigning the European patent grant procedure. However, these provisions and their legal framework seem to require considerable realignment, for several reasons.

In an actual case, the EPO issues a communication under Rule 161(1) and Rule 162 EPC stamped „for the Examining Division“ and indicating telephone number +31(0)70 340 4500, i.e. the EPO user support, for

enquiries, the communication inviting the applicant to correct the deficiencies noted in the written opinion of the International Searching Authority. The applicant's patent attorney thoroughly and with all due care studies the written opinion and finds no deficiency, in particular finds no objection as to lack of unity, and an indication of the allowability of the claims. The patent attorney calls the telephone number (a long distance call) and asks why an invitation was issued if no deficiencies are discernable. Less than two hours later, an EPO employee calls back and after discussing the situation he indicates that a communication will be issued stating that no deficiencies

<sup>17</sup> See Rules 31 to 34 EPC

<sup>18</sup> See Rule 32 EPC



exist and that no reaction is required. The patent attorney asks when the latter communication may be expected to arrive since the term of one month triggered by the first communication is running and is advised that the communication will be issued in about a week, well before the term expires. The expected communication arrives, signed „for the Examining Division“ and indicating a formalities officer.

This seems to indicate that the communication under Rules 161(1) and 162 EPC was issued as a standard letter by a formalities officer acting for the Examining Division, without any previous examination – performed by an examiner – if the written opinion of the ISA indicates any deficiency or not. Applicants might ask why they paid an examination fee if the Examining Division does not perform any real examination at this stage of the proceedings. Applicants might also ask if it is fair to them if the EPO, by issuing standard letters without an examination of the factual basis of each particular case, imposes onto them efforts and corresponding costs for noting and monitoring terms, consultations with the EPO, legal analysis, and related matters.

The present case occurred in May 2010 and is made even more obscure by the EPO President's decision of May 11, 2010 appearing on the EPO website on May 25 and entering into force on June 1. The decision concerns the entrustment to non-examining staff of certain duties, i.e. invitations under Rules 161(1) and 162 EPC. This would mean that any invitation issued by non-examining staff prior to June 1 might be considered null and void (and would have to be issued again in order to have legal effect).

However, this is not where the obscurities end, since the President's decision seems to be in conflict with the pertinent Rule of the EPC (Rule 161 according to CA/D 20/09, and not CA/D 3/09, of the Administrative Council). According to Rule 161(1), 1<sup>st</sup> sentence EPC, there is a „communication“ which triggers a term of one month, and according to Rule 161(1), 3<sup>rd</sup> sentence EPC, there is an „invitation“ which may cause that the European patent application is deemed to be withdrawn if the applicant fails to react. In the three official languages DE, EN, FR of the EPC the following terms are used, in the 1<sup>st</sup> sentence of Rule 161(1): DE Mitteilung; EN communication; FR notification; and in the 3<sup>rd</sup> sentence of that provision: DE Aufforderung; EN invitation; FR invitation.

Now, as a result of the President's decision, the non-examining staff are entrusted with the following duties: DE Mitteilungen; EN invitations; FR notifications. Based on the DE and FR versions and contrary to the EN version this would mean that non-examining staff would only be entrusted with issuing a communication under Rule 161(1), 1<sup>st</sup> sentence EPC, but not an invitation under Rule 161(1), 3<sup>rd</sup> sentence. In other words, such invitations would be null and void, and no terms concerning such invitations would have to be noted and monitored. It seems highly questionable whether this result was intended by the lawmakers.

A further obscurity concerns Article 94(3) and Rules 36, 71, 161, 162 EPC. Although according to point I(a),

2<sup>nd</sup> paragraph of the Notice from the EPO dated August 20, 2009 (OJ EPO 10/2009, 481) the „Examining Division's first communication“ (under Rule 36(1) EPC) is a communication under Article 94(3) and Rule 71(1), (2) EPC or, where appropriate, Rule 71(3) EPC, the EPO Notice provides no legal basis for this opinion. In particular, it remains an open question why the communication under Rule 161(1) and Rule 162 EPC should not be regarded as a 1<sup>st</sup> communication under Rule 36(1) EPC, although it is issued by the Examining Division.

The opinion that a communication under Rules 161(1) and 162 EPC triggers the time limit of 24 months under Rule 36(1)(a) EPC was already presented by S. Frischknecht and H. Kley in their article (in the German language) in epi Information 03/2009, 93 – 99 which questions the accumulation of amendments of the EPC Implementing Regulations performed by the EPO Administrative Council.

On June 14, 2010 the EPO issued an „Important Notice“ indicating that section A-IV, 1.1.1.2 of the Guidelines for Examination has been modified, that the modification was performed in order to clarify that the list of events from which the period for voluntary division is calculated is exclusive; and that in particular, a communication under Rule 161 EPC issued by the Examining Division does not qualify as the „Examining Division's first communication“ within the meaning of Rule 36(1)(a) EPC.

The modification involves amending the previous term „events“ to read „only events“ in the second sentence of section A-IV, 1.1.1.2 as follows:

#### „1.1.1.2 Voluntary division

A divisional application may be filed on the basis of a pending earlier (parent) application before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued (see, however, IV 1.1.1.3). The only events from which the period for voluntary division is calculated are:

- (i) Notification of a first communication according to Art. 94(3) and Rule 71(1), (2), where this is not preceded by a communication according to Rule 71(3), or
- (ii) Notification of a communication according to Rule 71(3), where this is not preceded by a communication according to Art. 94(3) and Rule 71(1), (2).“

However, the modification does not seem to constitute a clarification but a mere indication of the manner how the EPO intends to handle the requirements of Rule 36 EPC. The question arises if this manner of handling is in conformity with the EPC or, in other words, if an applicant or a patent attorney may rely on the EPO's opinion set forth in the Guidelines that only the events indicated in section A-IV, 1.1.1.2 trigger the time limit under Rule 36(1)(a) EPC (whereas a communication under Rules 161 and 162 EPC does not).



This item is important since a divisional application, or a European patent granted thereon, would be invalid if the divisional application was filed after the expiry of the term of twenty-four months under Rule 36(1)(a) EPC, with corresponding implications e.g. in patent infringement proceedings and, of course, regarding professional liability. It is particularly worth mentioning that the item of validity of the national part of a European patent will be determined by a national court.

It is to be noted that the Guidelines which are internal administrative instructions adopted by the President of the EPO under Art. 10(2)(a) EPC are addressed primarily to EPO staff and do not constitute legal provisions, as acknowledged in sections 3.1, 3.2 of the General Part of the Guidelines where it is therefore pointed out:

„For the ultimate authority on practice in the EPO, it is necessary to refer firstly to the European Patent Convention itself including the Implementing Regulations, the Protocol on the Interpretation of Article 69 EPC, the Protocol on Centralisation, the Protocol on Recognition, the Protocol on Privileges and Immunities and the Rules relating to Fees, and secondly to the interpretation put upon the EPC by the Boards of Appeal and the Enlarged Board of Appeal.“

A Board of Appeal held in the decision T 162/82 (OJ EPO 1987, 533) according to head note I and point 9 of the reasons, that:

- Under Art. 23(3) EPC the Guidelines do not bind any Board of Appeal (BOA)
- A BOA judges whether an EPO Division has acted in conformity with the EPC and not whether it has acted in accordance with the Guidelines
- Art. 15(2) (now Art. 20(2)) RPBA only prescribes that the BOA should state the grounds for its action if it gives a different interpretation of the Convention to that provided for in the Guidelines, if it considers that this decision will be more readily understood in the light of such grounds.

Since Rule 36(1)(a) EPC relates to the Examining Division's first „communication“, and similarly Rule 161(1) relates to a „communication“ (issued by non-examining staff, i.e. a formalities officer, as noted above, for the Examining Division) there does not seem to exist any legal uncertainty which might be „clarified“ by the EPO notice of June 14, 2010 and the corresponding amendment of section A-IV, 1.1.1.2 of the Guidelines.

Although under Art. 125 EPC and the principle of good faith and protection of legitimate expectations (Singer, Stauder, Europäisches Patentübereinkommen, 5<sup>th</sup> ed. (2010), recitals 8 – 14 of Art. 125) an applicant might be tempted to rely on the Examination Guidelines, caution (and therefore reliance on the clear legal situation under Rules 36 and 161 as outlined above) seems more appropriate, c.f. the decision G 2/93 (OJ EPO 1995, 275) in which the Enlarged Board of Appeal held in point 14 of the reasons, that whether the Guidelines, a general practice of the EPO based thereupon or other special circumstances of the case may have given rise to legitimate expectations on the part of the appellant, to a

certain effect, is left to the referring Board of Appeal to consider on the basis of supporting facts, evidence and arguments that may be submitted to it.

R. Teschemacher (VPP-Rundbrief Nr. 2/2010, 61 – 70, footnote 20) points out that also a communication of a formalities officer who requests an authorization, is an Examining Division's communication according to the wording of Rule 36 EPC, but thinks that the case law of the Enlarged Board of Appeal, e.g. G 2/93, seems to justify that an applicant may rely on the text of the Guidelines which unequivocally lags behind the wording of Rule 36 EPC.

However, see also the decision R 4/09 of April 30, 2010 in which the Enlarged Board of Appeal held in points 2.3.1 – 2.3.3, 2.4 of the reasons that, whereas the principle of good faith also known as the principle of the protection of legitimate expectations, in proceedings before the EPO, is generally recognised among the Contracting States of the EPC and is well established in European Union Law (G 2/97, OJ EPO 1999, 123), users of the European patent system, who are parties in proceedings before the EPO must act in good faith, and have the responsibility to take all necessary procedural actions to avoid a loss of right, and it remains nevertheless that the party, at least where it is represented by an authorized representative, is expected to be aware of the relevant law and case law, and cannot plead lack of such knowledge as an excuse, „Ignorantia legis non excusat“.

According to the Notice (in the German language) of the EPO of June 29, 2010 concerning communications under the amended Rule 161 EPC (on July 16 the Notice was made available in the English and French languages) a Rule 161 Communication is an essentially formal communication without a substantial content of its own, and therefore does not trigger the time limit for the voluntary or mandatory filing of divisional applications under Rule 36(1) EPC. In this respect the EPO observes that Rule 31(1) EPC does not explicitly refer to a „substantial communication“ but presents the opinion that, in accordance with the history of the legislation, the applicant should have the opportunity to file divisional applications after having been informed of the Examining Division's opinion regarding the conformity of the application with the requirements of the EPC. However, a Rule 161(1) Communication – issued by the Examining Division as correctly observed by the EPO – does in fact inform the applicant of the Examining Division's opinion in this respect, at least in those cases where the Rule 161(1) Communication contains an invitation to correct any deficiencies noted in the previous written opinion of the International Searching Authority or the International Preliminary Examining Authority.

Under section II, point 5 of the EPO Notice of June 29, the EPO provides an explanation of the above-mentioned actual case and admits that an invitation to correct deficiencies under Rule 161(1) will be communicated to the applicant by EPO Form 1226A even if the written opinion of the International Searching Authority or the International Preliminary Examining Authority was positive, i.e. did not mention a deficiency. The EPO

indicates that it will proceed as follows in such cases: if the applicant has not reacted, within the time limit of one month under Rule 161(1), on the Rule 161(1) Communication, then the EPO will examine if the previous written opinion was positive or negative, and will if it was negative, issue a Noting of loss of rights under Rule 112(1) EPC. The EPO concedes that in such „transitional cases“ (where the international search report or the international preliminary examination report was drafted prior to April 1, 2010) applicants may receive EPO Form 1226A in which they are invited to react on a positive written opinion, although in reality no loss of rights occurs if the applicant does not file a comment. The EPO Notice does not contain any advice regarding the proper handling of such cases by the applicant or a

professional representative, e.g. in respect of noting and monitoring time limits, inspection of the physical file of the application, communication between the representative and the applicant, and related matters.

The obscurities and/or inconsistencies outlined above lead to a vast area of legal uncertainties for applicants and legal practitioners in respect of determining terms to be observed under the EPC. It is to be expected that these legal uncertainties will remain for a considerable amount of time, i.e. until a clarification due to a decision of a Board of Appeal or, as the case may be, of the Enlarged Board of Appeal. This situation is unsatisfactory, to say the least, and should be remedied by appropriate measures as soon as possible.

## Yet another item about new Rule 36 ...

A. Vögele (AT)<sup>1</sup> and H. Nemeč (AT)<sup>2</sup>

Several articles in the previous issues of epi information<sup>3</sup> impressively demonstrate the dangers for applicants and representatives arising from the numerous changes of the Implementing Regulations that entered into force on 01 April 2010. The comments and analysis of the authors of these articles make it clear that some of the new Rules introduce ambiguities and uncertainties amongst applicants and representatives. Of course the changes regarding Rule 36 are amongst the most severe changes for applicants for preserving the right of getting protection for their invention(s).

Even though some of the applicants and representatives are not happy with the limitation of the right to file divisional applications at an early stage these applicants and representatives should accept these changes and try to find ways to minimise the risks in order to meet relevant deadlines. One positive idea behind new Rule 36 is that the public should be in a more secure situation about the patent situation at an earlier stage and that some „black sheep“ that have been abusing the EPC should be stopped from doing so. While this goal is positive in principle, we are afraid that with new Rule 36 it is probably not achieved as intended by the lawmakers.

Rule 36 (1) a) that entered into force on 01 April 2010 provides a new regulation for the „voluntary division“ of

an application. According to Rule 36 (1) a) an applicant „may file a divisional application relating to any pending earlier European patent application, provided that the divisional application is filed before the expiry of a time limit of twenty-four months from the Examining Division's first communication in respect of the earliest application for which a communication has been issued“.

As Wegner and Teschemacher<sup>4</sup> showed, even calculation of the time limit for filing a divisional application is not without risk for those simple cases where the applicant wants to file only a single divisional application (EP2) for a parent application (EP1). The applicant has to file the divisional application within the 24-month term after the first communication for EP1 AND EP1 has to be pending. However, the applicant himself has to monitor the first communication of the Examining Division which bears certain risks.

The situation becomes more complex for those cases where an applicant wants to file a divisional application EP3 (second generation) based on an application EP2 that is a divisional application (first generation) of the parent application EP1. One standard case is highlighted in the „Guidelines for Examination in the European Patent Office“ (Guidelines) of April 2010. According to the Guidelines, Part A – Chapter IV, 1.1.1.4:

*„For the filing of second-generation divisional applications (i.e. divisional applications based on an earlier application which is itself also a divisional), the event which starts the period for voluntary division is the first*

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2 European Patent Attorney and Österreichischer Patentanwalt at Schwarz & Partner, Wipplingerstraße 30, 1010 Wien, AT.

3 S. Frischknecht and H. Kley epi information 1/2010, 10; N. Blockhuis, epi information 2/2010, 49; W. Wegner and R. Teschemacher, epi information 2/2010, 53; S. Frischknecht and H. Kley epi information 3/2009, 93

4 W. Wegner and R. Teschemacher, epi information 2/2010, 53

communication in respect of the earliest application for which a communication has been issued. This is determined as illustrated by the following example:

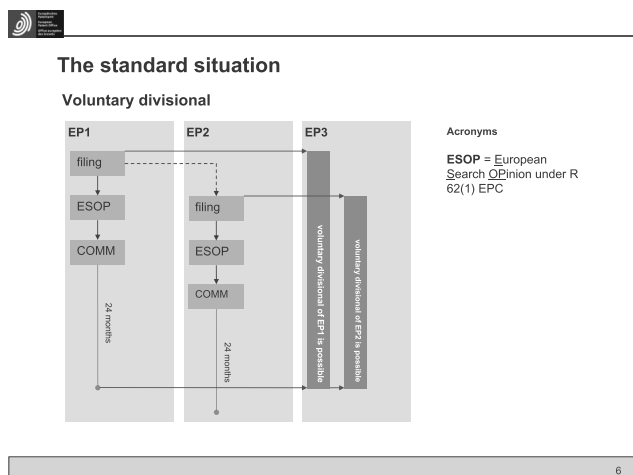
#### Example 1

- EP1 is the original European application,
- EP2 is a divisional application based on EP1 and
- EP3 is a divisional application based on EP2.

Where a first communication (see IV, 1.1.1.2) has already been issued for EP1 when EP3 is filed (this is the usual situation), the period for voluntary division of EP2 (by the filing of EP3) is calculated from the date of notification of this first communication in respect of EP1.

However, all that is required is that EP2 is still pending when EP3 is filed; EP1 does not need to be pending. This is because EP1 is the earliest application in respect of which a first communication has been issued (used to calculate the period for voluntary division), but it is not the earlier application which has been divided (this is EP2), and it is the earlier application (EP2) which must be pending according to Rule 36(1)."

The EPO collected all relevant documents of the most recent changes under <http://www.epo.org/patents/law/legal-texts/epc/changes-2010.html>. The EPO also published a presentation („The Presentation") that can be accessed from this website<sup>5</sup>. This presentation deals with several cases and provides help for the applicant (and their representatives) how to calculate the time limits. The above mentioned „standard case" according to the Guidelines is highlighted in slides 6 and 8 of The Presentation:

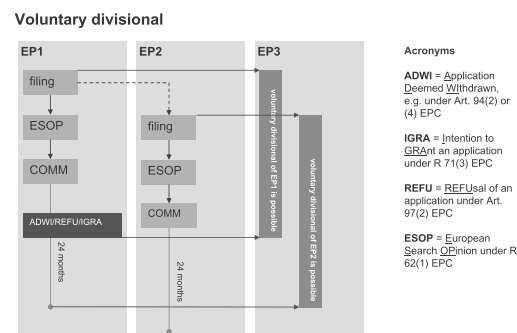


<sup>5</sup> The mentioned presentation is available in all three languages and can be downloaded at (last accessed on 12 August 2010): [http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/\\$File/Divisional\\_applications\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/$File/Divisional_applications_en.pdf), (EN-version)  
[http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/\\$File/Aktuelle\\_Aenderungen\\_des\\_EPUe\\_Europaeische\\_Teilanmeldungen\\_de.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/$File/Aktuelle_Aenderungen_des_EPUe_Europaeische_Teilanmeldungen_de.pdf) (DE-version)  
[http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/\\$File/Divisional\\_applications\\_fr.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/$File/Divisional_applications_fr.pdf) (FR-version)

<sup>6</sup> All Figures are taken from: [http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/\\$File/Divisional\\_applications\\_en.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/7DCD945C15C7E7D4C125770D003AF872/$File/Divisional_applications_en.pdf)



#### Standard situation, with lapse of earliest application



However, what happens in those cases where a first communication of the Examining Division for EP2 is issued before the first communication for EP1?

Frischknecht and Kley<sup>7</sup> discussed two cases in a previous issue of epi information:

„Case 1: the first communication for EP2 is dated 30.04.2012 and the first communication for EP1 is dated 31.08.2012.

Case 2: the first communication for EP2 is dated 30.04.2012, EP1 was withdrawn in February 2014 and no first communication was issued for EP1.”

(S. Frischknecht and H. Kley 1/2010, 11)

Frischknecht and Kley provide two interpretations:

„Interpretation A: The time limit of 24 months can be calculated from the issue date 30.04.2012 (EP2), as EP2 is regarded as „earliest application for which a first communication has been issued" in the sense that the first communication for EP2 was the earliest communication ever issued in the sequence of EP1 and EP2.

Interpretation B: Alternatively one can interpret R 36(1)a) in the sense that EP1 is, in an absolute sense, the „earliest application" (very first filing) and a first communication was issued for this application. It is thus unclear whether the condition „for which a first communication was issued" has to be read as a simple addition to the „earliest application" (interpretation B) or as a condition having an influence on the determination of „earliest" (interpretation A), and the end date can either be 30.04.2014 (based on EP2; interpretation A) or 31.08.2014 (based on EP1; interpretation B)“

(S. Frischknecht and H. Kley epi information 1/2010, 11)

Frischknecht and Kley further discuss that the EPO seems to follow interpretation B but they have doubts that this kind of interpretation is consistent:

„In case 2, EP1 remains still the „earliest application" of the sequence of divisional applications in absolute terms (very first filing). However, as there exists no first communication for EP1, there is no starting date of the time limit of 24 months based on EP1. Interpretation B of R 36(1)a) is then not applicable. So, in order to be able to calculate a time limit of 24 months at all, interpretation A

<sup>7</sup> S. Frischknecht and H. Kley epi information 1/2010, 10

seems to be relevant, as there exists only one first communication, namely that for EP2. EP2 is then regarded as „earliest application for which a first communication has been issued“. Is the EPO allowed to apply interpretation A for case 2, when interpretation B is published in the notice? Supposing a consistent application of interpretation B (as contained in the notice), in case 2 there would be never a starting date for the time limit of 24 months, so that there would exist a legal circumvention of the time limit of 24 months for filing divisional applications. This, however, was certainly not the intention of the EPO striving for a reduction of the divisional applications.

As can be seen from cases 1 and 2 and interpretations A and B of R 36(1)a), the legislation with respect to voluntary division has severe defects and is in no way consistent and concise for all supposable cases. The notice of the EPO causes confusion with respect to the interpretation of R. 36(1)a). The new provisional Guidelines give in A IV 1.1.1.4 some guidance, but they reflect only the opinion of the EPO and some standard cases. The true intention and meaning of „first communication of the earliest application for which a communication has been issued“ has to be given by a decision of a board of appeal. However, until such a case will arise and be decided there remain several years of legal uncertainty.”

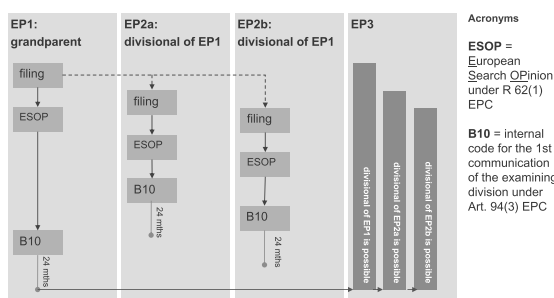
(S. Frischknecht and H. Kley epi information 1/2010, 10)

## The Presentation shows on slides 7 and 9 that the EPO in fact seems to follow interpretation B:



### First communication in the earliest application for which a communication has been issued

The interpretation of "earliest communication"

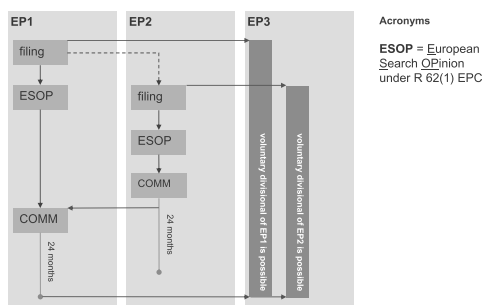


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### Late first communication in the earliest application

Voluntary divisional



9

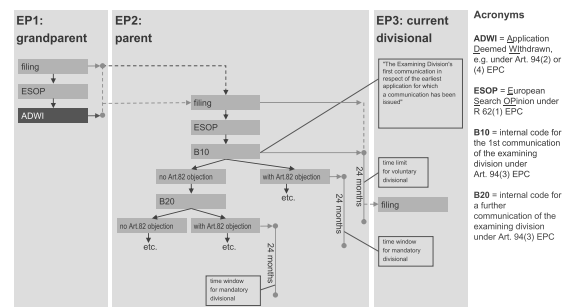
In a sequence of divisional applications EP1 (= parent) – EP2 (daughter) – EP3 (grand daughter) the EPO seems to follow the interpretation that the first relevant communication is that for EP1 without looking at communications from the Examining Division for EP2.

If applicants act upon this interpretation they might follow the strategy to avoid a first communication for EP1. Most simply they should achieve this goal by avoiding that the application is transferred to the Examining Division. Naively spoken in this case the 24-months term for a voluntary division would never be triggered. Of course this workaround was never intended by the lawmakers. Neither the Guidelines nor The Presentation explicitly deal with this case in the chapter for voluntary division. However, in the interpretation of mandatory division the EPO implicitly analysed such a case in The Presentation (Slide 14):



### Mandatory divisionals, early lapse of earlier application

Early lapse of an earlier application



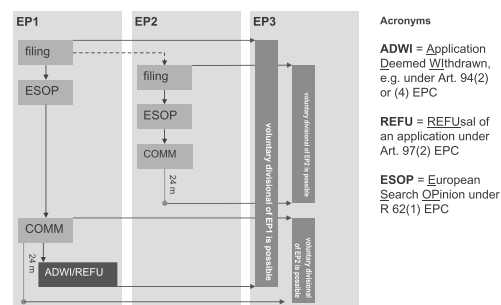
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As can be seen in the slide in this case EP1 is deemed to be withdrawn before a first communication was issued. However, as can also be seen in this slide the EPO suddenly calculates the 24-months term from the first communication for EP2. Seemingly, the EPO simply switches from interpretation B to interpretation A in such a case. To our understanding and also according to Frischknecht and Kley there is no legal basis to arbitrarily switch from one interpretation to another. Especially, by considering slide 10 of „The Presentation“ the applicant can prolong the time limit far beyond 24-months for filing a divisional if the term is to be calculated from the first communication of EP1 and not EP2:



### Very(!) late first communication in the earliest application, with subsequent lapse

Voluntary divisional



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As Frischknecht and Kley already stated the interpretation of the EPO might not be in line with the intention of the Administrative Council by implementing Rule 36 (1) a). However, positively speaking for the applicant, the interpretation of the EPO in many cases provides more than 24-months for filing a divisional application by not relying on ANY first communication to ANY application (parent or daughter) but on the FIRST communication of the FIRST application.

According to Frischknecht and Kley (epi information 1/2010) the „true intention and meaning of 'first communication of the earliest application for which a communication has been issued' has to be given by a decision of a board of appeal. However, until such a case will arise and be decided there remain several years of legal uncertainty.“ If the EPO strictly follows the interpretation of The Presentation such a decision of a Board of Appeal might take very long to come: If the EPO findings are that a divisional application is admissible under the circumstances shown in The Presentation the time limit for filing a divisional application could be significantly longer than in a strict interpretation of Rule 36. Accordingly, there should be no need for the applicant to file an appeal if the EPO generously handles the time limit. Additionally, third parties have no opportunity to file an appeal against a divisional application that should have not been admissible using a strict interpretation of Rule 36. Inadmissible filing of a divisional application is no reason for opposition so third parties will never have the opportunity to fight against an inadmissible divisional application. Accordingly, EPO's interpretation of Rule 36 is in favour of the applicant.

One intention of new Rule 36 was to stop the abuse of a few applicants who file numerous divisional applications and keep the public in an unknown situation about possible future patents. However, those abusing the „old“ system will be able to (and most certainly will)

also abuse the new system as long as the interpretation of Rule 36 is unclear: they will most simply do everything to avoid a first communication for the first application.

Most announcements of the EPO including The Presentation are not legally binding and as Frischknecht and Kley say it will be up to the (Enlarged) Boards of Appeal to resolve this situation.

However, the recent changes of the Implementing Regulations by the Administrative Council clearly demonstrate one thing: The revised Convention (EPC 2000) introduced many provisions that allow the EPC to more flexibly adapt the EPO to changes in the global patent system in general. With 38 member states in the future it will be very difficult to amend the EPC during a Diplomatic Conference so there was a strong need to simplify certain changes. In addition the Administrative Council now also has the power to introduce new Rules to avoid abuse of the system which in principle is positive. Unfortunately, the many changes of the Implementing Regulations by the Administrative Council within the last 2 ½ years (and there are more to come in the next couple of months) introduced ambiguities and uncertainties for applicants, representatives AND the EPO. „Black sheep“ will in the future still find ways to utilise these ambiguities and uncertainties and to abuse the system and seemingly the Administrative Council should reconsider introducing numerous and sometimes not perfectly worked out changes of the Implementing Regulations in the future which decreases ambiguities and uncertainties amongst applicants, representatives and also the EPO. However, as it is in the interest of applicants, representatives and the EPO to have a stable and reliable patent system, it is also up to the applicants and representatives to collaborate with the EPO and the Administrative Council to improve future legislation.

## Vom Patentanspruch zum verlässlichen Rechtstitel

A. W. Kumm (DE)

G. Brose<sup>1</sup> gibt dies zu überlegen: Ist die Zurückweisung einer Patentanmeldung durch das EPA rechters, wenn in einen Patentanspruch, der auf eine Gerätschaft gerichtet ist, die Merkmale eines nichttechnischen Vorganges nicht eingefügt wurden?

Auch nach über 150 Jahren der Patentgestaltung liegt augenscheinlich immer noch das technisch-wissenschaftliche (= technologische) Erkennen und Analysieren von technischen Objekten, deren begriffslogisches Definieren und auch deren Abgrenzen im Argen: Immer

noch zweifelhaft ist, was ein technischer und was ein nichttechnischer Vorgang ist oder wie ein erfundenes Objekt – technisch geschaffen als ein materieller Aufbau (technisches Gerät) oder als eine zeitliche Abfolge materieller Vielkörpersysteme (technisches Verfahren) – technologisch eindeutig festgestellt und festgesetzt wird<sup>2</sup>.

1 Brose, G.: Nichttechnische Anspruchsmerkmale. In: epi Information 2/2010, S. 55-56. Der Tatfall betrifft die Anmeldung 98440204.0 (EP 911763 A 2).

2 Dazu Kumm, A. W.: Wie fortschrittlich ist die Patentrechtswissenschaft? In: Mitteilungen der deutschen Patentanwälte, 78/1987, S. 234-236. (u. a. eine Kurzfassung zum Erkennen, Analysieren und Definieren beliebiger technischer Objekte und speziell Regeln zur Form der Ansprüche). Ferner Kumm, A. W.: Vom Spezialisten zum Generalisten der Technik – ein Wegweiser zum technologischen Denken, Analysieren und Bewerten –. Frankfurt a.M., 2003, ISBN 3-899846-264-1.



## Zum speziellen Problem

Der Gegenstand der genannten EP 911763 A 2 ist m. E. gattungsmäßig zu definieren als ein System zur Ermittlung der Benutzungsgebühr für die Strecke zwischen zwei Baken, beruhend auf den manuellen Eingaben der – am Fahrstrecke-Zählgerät eines Fahrzeuges abgelesenen – Fahrstrecke-Ist-Zahlen an der ersten und an der zweiten Bake und auf deren nicht materiellen Übertragung auf die Baken zur Gebührenberechnung.

Das EPA hatte offenbar gemeint, dass das Ablesen jener zwei aktuellen Messwerte und ihr manuelles Eintippen ein wesentliches Kennzeichen des Systems sei. Bloßes Ablesen und Eintippen sind jedoch triviale, von der Gerätekonstruktion abhängige Bedienungs-Vorgänge<sup>3</sup>. Zur Begründung und Abgrenzung der einschlägigen Phänomene das Folgende.

Eine „technische“ Erfindung – das ist eine physisch-sozio-ökonomisch geschaffene Erfindung – ist ontologisch *entweder* ein technischer Aufbau aus elementaren Vielkörpersystemen (technisches Gerät, Vorrichtung, Anordnung, Erzeugnis, Einrichtung) *oder* eine Abfolge nacheinander folgender, energetisch verknüpfter *menschlicher* Handlungen an und mit Vielkörpersystemen (technisches Verfahren)<sup>4</sup>.

Von diesen technischen Verfahren sind unbedingt zu unterscheiden alle Methoden, Lehren, Anweisungen usw. zum Ermitteln, Vermitteln oder Deuten neuer Erkenntnisse oder zum Schreiben eines Algorithmus, denn sie bedienen sich nur intellektueller Mittel (logischer Operationen). Sie sind nicht patentierbar, denn jedes Denken und Nach-Denken ist a priori nicht justizierbar. Irreführend ist, derartige Gedankenfolgen als technische Verfahren zu bezeichnen, nur weil sie ebenfalls zeitliche Vorgänge sind.

Im Betriebszustand eines technischen Gerätes stellen sich auf Grund seiner Konstruktion technische Funktionen ein, die in und zwischen seinen energetisch verbundenen Vielkörpersystemen (Bauteilen) nacheinander ablaufen. Diese Wirkungen sind naturgesetzlich bedingt und auch nicht justizierbar. Sie haben daher keinen Platz in einem Patentanspruch. Derartige Wirkungsweisen sind auch keine technischen Verfahren, als die sie oft verkannt werden.

Das Bedienen oder Gebrauchen eines Gerätes, etwa sein Ein- und Ausschalten, das Auffüllen mit einem zu verändernden Stoff u. ä. sind nur bestimmungsgemäße Reflexe, zu denen auch ein schlichter menschlicher Verstand angelernt werden kann. Entsprechende Merkmale sind trivial und daher nicht patentierbar. Auch sie haben keinen Platz in einem Patentanspruch. Schließlich sind auch sie keine technischen Verfahren.

Auch aus rein rechtlicher Sicht haben naturgesetzliche Funktionsabläufe im Betriebszustand eines Gerätes und dessen Bedienen oder Gebrauchen nichts in einem Patentanspruch zu suchen: Zum einen endet das kreative

Verdienst des Erfinders mit seinem Erfundenen. Zum anderen muss man eine geschützte und rechtmäßig in den Verkehr gebrachte Erfindung benutzen dürfen, ohne dass jedes Betreiben, Bedienen, Gebrauchen noch einer Einwilligung des Rechtsinhabers bedürfe. (Grundsatz der Konsumption oder Erschöpfung der Befugnisse, der auf J. Kohler zurückgeht<sup>5</sup>.)

## Zum allgemeinen Problem

Der Art. 69 EPÜ bestimmte bis zu seiner Revision von 2000: „Der Schutzbereich ... wird durch den Inhalt (*terms, teneur*) der Patentansprüche bestimmt“. Seither ist nur festgesetzt: „Der Schutzbereich ... wird durch die Patentansprüche bestimmt“. Das Merkmal „Inhalt“ wurde gestrichen, denn es sei „somewhat unclear in scope“<sup>6</sup>.

Doch genau das Gegenteil trifft zu: „Inhalt“ (Begriffs-Inhalt) ist ein klarer terminus technicus der Begriffs-, Definitions-, Urteils- und Schlusslogik. Er ist, kurz gesagt, „der Inbegriff aller Merkmale, die wir, als das Wesen einer Sache bestimmend, konstituierend in einer Reihe von Urteilen aussagen können“<sup>7</sup>. Allgemein gilt: Die Realdefinition eines Phänomens verkörpert dessen Begriffsinhalt und determiniert eindeutig dessen Wesen. Der Begriffsinhalt determiniert logisch zwangsläufig auch dessen „Begriffs-Umfang“. Das bedeutet speziell: Der „Inhalt“ (Begriffsinhalt) einer zu patentierenden technischen Erfindung wird nur dann eindeutig festgestellt, wenn ihr Patentanspruch als Realdefinition mit ihrem Gattungsbegriff und mit ihrem Artbegriff formuliert ist. Im „Gattungsbegriff“ sind auch die den Begriffsinhalt bestimmenden, aber nicht schutzfähigen Merkmale darstellbar; im Übrigen ist ein „Gattungsbegriff“ nicht der technisch und logisch sonderbare „Oberbegriff“. Ein so definierter Schutzzinhalt determiniert also auch den Schutzzumfang („Schutzbereich“)<sup>2</sup>.

Der jetzt gültige Art. 69 EPÜ und das zugehörige „Protokoll“<sup>8</sup> verfestigen gewiss das alte deutsche, die Patentansprüche abtadelnde Dogma, dass erst und nur „der Verletzungsrichter“ – das ist, genauer gesagt, ein Richterkollegium plus technischen Sachverständigen – in einem Schadensersatzprozess wegen Patentverletzung den Rechtsbereich (Schutzzumfang) eines Patentanspruches festsetze. Dieses pure Richterrecht entwertet jeden erteilten Patentanspruch – jeder war meist nach kostspieligen, geistreichen, schweißtreibenden Filigranarbeiten von hoch bezahlten Patentrechtlern geschmiedet worden – zu einem bloßen, wohlfeilen Konstrukt. Die Schweizer hatten dieses pure Dogma bewusst abgelehnt<sup>9</sup>.

5 J. Kohler, Handbuch des Deutschen Patentrechts in rechtsvergleichender Darstellung. Mannheim, 1900, S. 452.

6 Casalonga, A.: Revision of the European Patent Convention. In: epi Information 2/2002, S. 46. (Die deutsche Jurisprudenz hielt das Wort „Inhalt“ vielleicht auch für unklar, denn bei „Inhalt“ denkt man zunächst an den § 119 BGB (Unbewusstes Auseinanderfallen des Inhalts von Wille und Erklärung).

7 Eisler, R., Wörterbuch der philosophischen Begriffe, Berlin, 1904, Stichwort „Begriff“.

8 Protokoll über die Auslegung des Artikels 69 EPÜ vom 24.8.2007, BGBl. II S. 1082, 1191.

9 Das Dogma entstand schon zu Beginn des 20. Jahrhunderts im Methodenstreit zwischen der Begriffsjurisprudenz und der (letztlich siegenden) Freirechtsschule. Die Schweizer und ihr Bundesgericht machten diese Händel

3 So auch G. Brose a. a. O.

4 Im Deutschen bedeutet die Nomination „Erfindung“ sowohl das „Erfinden“ als auch dessen Ergebnis, das „Erfundene“. (Das Schlagwort „von dem die Erfindung ausging“ bedeutet „von dem das Erfinden (der Erfindensvorgang) ausging“.

Der Richtersatz und sein Primat ist die herrschende Meinung. Beispiele: „Die Auslegung obliegt dem Verletzungsrichter, setzt aber tatsächliche Feststellungen darüber voraus, was der Fachmann den Ansprüchen entnimmt“<sup>10</sup>. Ferner<sup>11</sup>: „Die Bemessung des Schutzes ... ist Sache des Verletzungsrichters“ oder (so ein BGH-Richter) „Die Merkmale bleiben drin, sie werden bei der Frage der Patentfähigkeit nicht berücksichtigt“.

### Zum Schluss

Ein Patent, von Natur ein absoluter subjektiver Rechtstitel (eine *lex specialis*), ist dann verlässlich, wenn seine Patentansprüche klassische Realdefinitionen sind. Der Satz vom „Verletzungsrichter“ ist dann *a priori* obsolet.

Bei der Gestaltung eigener und bei der Kritik fremder Patente ist es hilfreich, folgende Phänomene zu unterscheiden:

- Methode M (Lehre, Anweisung, Konstrukt) zum Ermitteln, Deuten, Vermitteln oder Verarbeiten einer neuen Erkenntnis oder etwa eines Algorithmus, gekennzeichnet durch ausschließlich intellektuelle Mittel.

nicht mit: Sie belehrten die Freirechtler, dass ein System richtiger sei, das durch enge Auslegung des Patentanspruches klare und sichere Rechte schaffe als ein System, bei dem die Rechtswirkungen erst nach langen und kostspieligen Prozessen feststehe.

<sup>10</sup> Schulte PatG, 5. Aufl., Rdn. zu § 14. PatG BRD und Art. 69 EPÜ.

<sup>11</sup> Zitiert nach G. Brose a. a. O. (letzte Spalte)

- Natürliches Vielkörpersystem, das in der Natur entdeckt wurde.
- Physikalisch-naturwissenschaftlicher, nur kognitiv ausgerichteter Vorgang zum Erzielen einer energetischen Wirkung, beruhend auf einer Methode M.
- Technisches Verfahren, gekennzeichnet durch den Einsatz ausschließlich technischer Mittel, zu denen auch Substanzen zählen können. (Das Produkt wird beispielsweise bei einem physikalisch-naturwissenschaftlichen Vorgang oder bei einem anderen technischen Verfahren eingesetzt.)
- Nichtselbsttätiges technisches Gerät, benutzt bei einer Methode M als Hilfsmittel zum Rechnen, Zeichnen u. ä. oder benutzt bei einem physikalischen Vorgang bzw. bei einem technischen Verfahren.
- Selbsttätiges technisches Gerät zum automatischen Durchführen einer Methode M, eines physikalisch-naturwissenschaftlichen Vorganges oder eines technischen Verfahrens.
- Verwendung eines Vielkörpersystems anstelle eines Andersartigen in einem bekannten technischen Verfahren („Verwendung“, „Anwendung“ bedeuten verkappte Verfahren).
- Funktionsablauf in einem nichtselbsttätigen oder selbsttätigen technischen Gerät, wenn es gehandhabt wird oder im Betrieb ist.
- Bedienen oder Gebrauchen eines solchen technischen Gerätes.

## Never ending notices of the EPO with respect to changes of the EPC coming into force on April 1<sup>st</sup>, 2010, by S. Frischknecht and H. Kley in epi Information 1/2010

Comment by D. Harrison (GB)

In epi Information 1/2010 Frischknecht and Kley point out quite correctly that new Rule 36(1)(b) is contrary to the Paris Convention (PC) and then regret that there is no instance which could check the conformity of the EPC with, *inter alia*, the PC. Of course it is true that there is no body which controls or checks the Administrative Council in its rule-making (which recently has been so lamentable from the point of view of safeguarding the interests of the users of the EPO and hence of the long-term interests of the Office), but it seems to me quite clear that when a rule is *ultra vires* a Board of Appeal can and should so hold. Here, the legal basis is found in Art. 164(2) of the EPC which declares that if there is conflict between the Convention and a Rule, the former shall prevail. Frischknecht and Kley mention A 19 PC; the preamble to the EPC declares that it is a special agree-

ment within the meaning of that Article; therefore Art. 4G(1) PC applies to the EPC, and that, as they state, does not contain any limitation of the right of division when faced with an objection of plurality. Hence the conflict.

They then turn to the question of the 24-month term. There are fundamental problems here also.

Consider: An objection of plurality is made. The applicant contests it. The Examining Division (ED) decides that its objection was correct and refuses the application on that ground. The applicant appeals. Will the appeal have been decided within 24 months of the objection having been made? Probably not, given the speed at which the Boards work, but that may not be relevant. Note the wording of Rule 36(1)(b); the term runs from the making of an objection, not from the making of a

*justified* objection, and it seems very doubtful whether a Board, even if it agrees with the applicant, has the power to annul a mere finding as distinct from a decision; nor can there be a suspensive effect in respect of a mere objection. So the applicant can only resolve his uncertainties by filing a precautionary divisional; when he finds that he was right all the time will he get a refund of all the fees which, the decision of the Board has established, were wrongfully paid?

If the applicant appellant fails in his appeal, he has after the decision of the Board no pending application that he can divide. He must as a precaution divide before the earlier of 24 months from objection, and the day before the Board reaches its decision.

He may never even get as far as appeal before the term runs out. An obstructive, indecisive or plain idle ED can

take more than the 24 months from the initial objection before an appealable decision is reached.

In all these cases the applicant cannot risk the uncertainties; in effect he must divide within 24 months whenever a plurality objection is made, even if he feels rightly that the objection is wrong.

In all these scenarios the applicant is being denied the possibility of any meaningful judicial review of an administrative action. Since there is as I have explained *de facto* administrative finality, such a situation would appear to be contrary to Art. 41.5 TRIPS. Of course the EPO is not party to TRIPS, but all except Monaco of its contracting states are and there could from this aspect also be an intriguing debate about the validity of the Rule.

## Nichttechnische Anspruchsmerkmale

Antwort von G. Kern (DE) an G. Brose (DE)

Die in epi-information 2/10, Seiten 55-56 aufgeworfene grundlegende Frage betreffend sogenannt nichttechnische Anspruchsmerkmale ist gewissermaßen einfach zu beantworten:

Nach Artikel 84 EPÜ müssen die Patentansprüche den Gegenstand angeben, für den Schutz begehrt wird. Das ursprünglich international sorgfältig verfasste Europäische Patentübereinkommen verlangte ausdrücklich nicht, dass eine Erfindung, die als geistiges Eigentum des Erfinders Patentschutz für einen Gegenstand rechtfertigen sollte, in Patentansprüchen anzugeben sei. Das Europäische Patentübereinkommen beweist sogar nach vielen Änderungen im Laufe der Zeit heute noch schlüssig, dass ursprünglich streng zwischen dem Gegenstand eines Patentanspruchs und der Erfindung zu unterscheiden ist/war, zumal ein ordentlich lesbarer Anspruchstext

sich in aller Regel ganz und gar nicht zur vollständigen Offenbarung einer Erfindung eignet. Die Literatur über Patentrecht insbesondere im deutschsprachigen Raum ist leider voll von Irrtümern über das, was Gegenstand eines Patentanspruchs sein kann und wie er sprachlich gestaltet sein sollte, damit er eindeutig auslegbar ist und so Rechtssicherheit erzeugt.

Im vorgängig dargestellten Beispiel einer Meinungsverschiedenheit zwischen Anmelder und Prüfungsabteilung des EPA gehört die manuelle Eingabe von Daten zweifellos nicht zum materiellen Gegenstand eines Patentanspruchs, wohl aber vielleicht zur Zweckbestimmung des Gegenstands und damit zu derjenigen Erfindung, die den Patentanspruch rechtfertigt. Die Erklärung manueller Dateneingabe im materiellen Sachanspruch stellt die erforderliche Rechtssicherheit des Anspruchs in Frage.

## Zu den Änderungen der Ausführungsordnung (AO) per 1. April 2010 und der Implementierung durch das EPA

S. Frischknecht (DE), H. Kley (CH)

Die auf den 1. April 2010 in Kraft getretenen Änderungen der AO verursachen unabhängig von ihrer Implementierung durch das EPA eine erhebliche Beeinträchtigung der Rechtssicherheit. Diese Problematik wurde von uns bereits angesprochen (vgl. EPI Information 03/2009 und 01/2010) und mittlerweile von weiteren Kollegen kritisch beurteilt, siehe z. B. in EPI Information 2/2010 die Beiträge „Mission impossible ...“ von H. Wegner und R. Teschemacher oder „The pitfalls in the swamp“ von N. Blokhuis.

Durch die vom EPA gewählte Implementierung wird der Vertrauensschutz noch zusätzlich untergraben. Beispielfhaft wird auf die „Mitteilung des Europäischen Patentamts vom 29. Juni 2010 über Mitteilungen nach der geänderten Regel 161 EPÜ“ hingewiesen, der in Ziffer 5 folgendes zu entnehmen ist: „... Folglich können Anmelder in diesen Übergangsfällen Formblatt EPA 1226A erhalten, mit welchem sie scheinbar zur Reaktion auf einen positiven WO-ISA oder IPER aufgefordert werden, obwohl in Wahrheit kein Rechtsverlust eintritt, wenn der Anmelder nicht Stellung nimmt.“ Der Anmelder oder der zugelassene Vertreter muss also entschei-

den, ob eine an sich klare Aufforderung des EPA tatsächlich korrekt ist oder ob eine solche Aufforderung ignoriert werden darf; im konkreten Fall muss entschieden werden, ob WO-ISR oder IPER positiv war oder nicht. Es ist rechtlich unklar, unter welchen Bedingungen der WO-ISR oder IPER als positiv zu bewerten ist. Beschränkt sich dies nur auf die Erfordernisse Neuheit und erfindnerische Tätigkeit oder aber auch auf Offenbarung, Klarheit, formelle Mängel.

Auch wenn das EPA maßgeblich an den Änderungen der AO mitgewirkt und deren Implementierung durch die erlassenen Mitteilungen zu verantworten hat, so trägt für die durchgeführten Änderungen der AO und die daraus resultierende Destabilisierung des europäischen Patentsystems letztlich allein der Verwaltungsrat die Verantwortung in seiner Funktion gemäß EPÜ Art. 33.

Der Verwaltungsrat wird daher aufgefordert, durch materielle Änderungen der AO, insbesondere Rücknahme der Änderungen vom 1. April 2010, weiteren Schaden am europäischen Patentsystem zu verhindern und das zerstörte Vertrauen wieder herzustellen.

## Book publication ABC/D Comprehensive

We would like to draw the attention of trainees to the recently-published book *ABC/D Comprehensive*, by Brian Cronin.

This book is a comprehensive analysis of the European Qualifying Examination for candidates preparing for the examination.

It is available from the printer [www.unibook.com](http://www.unibook.com) and you can obtain details by entering the key word „patent“.

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